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Can the Right of Publicity Afford Free Speech - A New Right of Publicity Test for First Amendment Cases

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Can the Right of Publicity Afford Free Speech? A New Right of Publicity Test for First Amendment Cases

by
JASON K. LEVINE*

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* JD Candidate, 2005, University of Connecticut School of Law; B.S. Northwestern University, 1994. The author wishes to thank: Professor Lewis Kurlantzick, University of Connecticut School of Law, for insisting I take "another look at the First Amendment"; Eric Goldstein, my personal Executive Editor; Ruth Kuper Levine, my mother, for her unwavering confidence in everything I have ever attempted; and Carin Rosenberg, my fiancée, without whose support and patience this article never would have been completed. This article is dedicated to the memory of my father, Leonard Levine, the man who taught me that we can only lead by example.

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Introduction

*Good name in man and woman, dear my lord,
Is the immediate jewel of their souls:
Who steals my purse steals trash—'tis something, nothing;
'Twas mine, 'tis his, and has been slave to thousands;
But he that filches from me my good name
Robs me of that which not enriches him
And makes me poor indeed.¹*

Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large. Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? . . . Surely this would have made the world poorer, not richer, culturally as well as economically.²

The First Amendment cannot permit anyone who cries 'artist' to have carte blanche when it comes to naming and advertising his works.³

The right of publicity celebrated its fiftieth anniversary in 2003.⁴ Yet, without immediate intervention the doctrine may not survive in any meaningful form to mark its centennial celebration. Conceived as a legal protection from the misappropriation or unauthorized exploitation of one's persona,⁵ the right is quickly being eaten alive by one of the oldest and most treasured rights in American jurisprudence: the First Amendment.⁶ The right of publicity is defined as the "inherent right of every human being to control the commercial use of his or her identity."⁷ The conflict that is the focus

1. WILLIAM SHAKESPEARE, *OTHELLO*, THE MOOR OF VENICE, act 3, sc. 3.

2. *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J. dissenting) (objecting to denial of rehearing en banc).

3. *Parks v. LaFace Records*, 329 F.3d 437, 463 (6th Cir. 2003).

4. The term "right of publicity" was coined by Judge Jerome Frank in his 1953 opinion *Halean Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.).

5. *Id.* at 868.

6. U.S. CONST. amend. I ("Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.").

7. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 (2d ed. 2003). McCarthy, one of the leading commentators in the field, also contends that the right

of this article generally arises when defendants invoke the First Amendment against a plaintiff who is attempting to exercise his or her right of publicity.⁸ This tension has never been addressed by Congress and has only briefly been discussed by the United States Supreme Court.⁹

As of March 2002, twenty-eight states had either passed right of publicity statutes or carved out a similar form of common law protection.¹⁰ Accordingly, courts at both the state and federal level have had to grapple with varying statutory definitions of the right itself, as well as a maze of common law decisions that have left many commentators clamoring for a federal right of publicity statute to settle the issue once and for all.¹¹ However, a federal statute would be unlikely to answer questions such as: How can a robust right of publicity coexist with the First Amendment? Can a right created for the purpose of protecting the commercial rights of celebrities function along side our societal predilection to protect both artisans and advertisers?

This article argues that the right of publicity and the First Amendment can be commingled, but that a new test is needed to help courts determine how much protection is too much protection. Both plaintiffs and defendants currently have to wade through conflicting state and common law tests when engaged in a right of publicity action where the First Amendment is implicated.¹² Recent decisions at

of publicity is a "distinct legal category" separate but interrelated to the disciplines of "trademark, copyright, false advertising or right of privacy." *Id.*

8. This article only examines the right of publicity and the First Amendment in the context of living plaintiffs. For an examination of the descendibility of the right of publicity see Peter L. Fletcher & Edward L. Rubin, *The Descendibility of the Right of Publicity: Is there Commercial Life after Death?*, 89 YALE L.J. 1125 (1980); Ralph H. Laurens, *Year of the Living Dead: California Breathes New Life into Celebrity Publicity Rights*, 24 HASTINGS COMM. & ENT. L.J. 109 (2001); Edward C. Wilde, *The Scope of Liability Under California's Right of Publicity Statutes: Civil Code Sections 990 and 3344*, 5 UCLA ENT. L. REV. 167 (1998).

9. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) (discussed *infra* Part III).

10. MCCARTHY, *supra* note 7 at § 6:3.

11. See generally Eric Goodman, *A National Identity Crisis: The Need for Federal Right of Publicity Statute*, DEPAUL-LCA J. ART & ENT. L. & POL'Y (1999) (advocating the need for a federal right of publicity); Eleanor Johnson, *Henley v. Dillard Department Stores: Don Loves His Henley, and Has a Right to it too*, 45 VILL. L. REV. 169 (2000) (advocating the need for a federal right of publicity); Richard S. Robinson, *Preemption, The Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183 (1998) (advocating the need for a federal right of publicity).

12. See Schuyler M. Moore, *Sex, Lies and Videotape: The First Amendment vs. The Right of Publicity for Expressive Works*, ENT. L. REP., VOL. 25, NO. 6, 4 (2003) (discussing recent decisions in the field).

both the state¹³ and federal levels¹⁴ only serve to highlight the confusion and lack of uniformity experienced by all parties involved in these actions.

This article will examine the right of publicity from the perspective that the right serves a valuable purpose in our media-driven society. There are economic, philosophical and moral reasons that the right of publicity is a positive development within our legal canon. However, just as with its predecessors copyright and trademark, the right of publicity must reach an accommodation with the First Amendment. Beginning with the newsworthy/public interest exception found in most publicity statutes and common law decisions, and progressing to a four factor test derived in part from the fair use exception to the Copyright Act¹⁵ and influenced by trademark's¹⁶ consumer confusion model, this article creates a new test to enable such an accommodation.

Part II will briefly review the history of the right of publicity, beginning with its roots in Louis D. Brandeis and Samuel D. Warren's article *The Right to Privacy*.¹⁷ It will then discuss the influence of the *Halean Labs., Inc. v. Topps Chewing Gum, Inc.*¹⁸ decision on Melville Nimmer's *The Right of Publicity*¹⁹ and the impact of both on the modern right of publicity.

Part III will discuss some of the more philosophical underpinnings of the right from both a legal and moral standpoint, and explore how these motivations have helped shape the current law with regards to the First Amendment. Part IV will survey the newsworthy/public interest exception to the right of publicity, while Part V will explore the elements of a new four factor test by which courts may determine if a plaintiff's right of publicity has been violated. Part VI will summarize the two significant recently created tests that attempt to resolve the tension between the right of publicity

13. Doe v. Cablevision, 110 S.W.3d 363 (Mo. 2003); Comedy III Prods., Inc. v. Saderup, Inc., 21 P.3d 797 (Cal. 2001).

14. ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003); Parks v. LaFace Records, 329 F.3d 437, 463 (6th Cir. 2003); Downing v. Abercrombie & Fitch, 265 F.3d 994 (9th Cir. 2001).

15. 17 U.S.C. § 107 (2004).

16. 15 U.S.C. § 1125 (2004).

17. Louis D. Brandeis & Samuel D. Warren, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890). This article has been referred to as "perhaps the most famous and certainly the most influential law review article ever written." Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

18. 202 F.2d 866 (2d Cir. 1953) (discussed *infra* Part II.B).

19. Nimmer, *supra* note 17.

and the First Amendment. Finally, Part VII will discuss the proposed four factor test and apply it to four recent right of publicity actions where the First Amendment was a major component of the decision.

I. History

A. The Right to Privacy

The right of publicity has been in tension with the First Amendment since its forbearer, the right to privacy, was conceived. Living in a time of pulp fiction and sensationalist yellow journalism,²⁰ Brandeis and Warren wrote that privacy must be protected from a press that was “overstepping in every direction the obvious bounds of propriety and of decency.”²¹ They believed the privacy of individuals was being sacrificed to “satisfy a prurient taste,” as “the details of sexual relations are spread broadcast in the columns of the daily papers.”²² This right to privacy for the common man and celebrity alike was concerned with the “affront to one’s human dignity”²³ that public disclosure of personal information was likely to produce.²⁴ Brandeis and Warren’s solution was to enable anyone so injured to recover from the offending party at law.²⁵

Yet, it was not as much the influence of the Brandeis and Warren article as it was the Court of Appeals of New York’s refusal to recognize the right of privacy²⁶ that spurred the New York Legislature to adopt the nation’s first statutory right to privacy in 1903.²⁷ Despite the New York statute often being viewed as the first right of publicity law in the nation, somewhat ironically (yet consistently) New York courts have maintained that the statute is *not* a right of publicity statute.²⁸

20. MCCARTHY, *supra* note 7, at § 1:13.

21. Brandeis & Warren, *supra* note 17, at 196.

22. *Id.*

23. Jeremy T. Maar, *Constitutional Restraints on State Right of Publicity Laws*, 44 B.C. L. REV 863, 866 (2003).

24. Brandeis & Warren, *supra* note 17, at 196.

25. *Id.* at 213.

26. *Roberson v. Rochester Folding Box Co.*, 171 NY 538 (N.Y. 1902). New York’s highest court ruled against the plaintiff’s emotional distress claim due to the defendant’s unauthorized use of the plaintiff’s picture in an advertisement. *Id.*

27. N.Y. CIV. RIGHTS LAW § 50 (2004).

28. Perhaps as much as any other factor, the reason that the right of privacy and publicity continue to be conflated is this stance of New York courts. Despite federal courts in New York maintaining (until the Court of Appeals of New York spoke definitively on the matter in 1984) that there was a common law right of publicity separate from the two

Nevertheless, the argument made in the Brandeis and Warren article was so convincing that beginning in 1905 courts across the country began to recognize the right to privacy at common law.²⁹ In the very first decision to recognize the right to privacy, the court was already keenly aware of the line drawing that would be necessary for this new right to comport with the First Amendment:

The stumbling block which many have encountered in the way of a recognition of the existence of a right of privacy has been that the recognition of such right would inevitably tend to curtail the liberty of speech and of the press. The right to speak and the right of privacy have been coexistent. Each is a natural right, each exists, and each must be recognized and enforced with due respect for the other.³⁰

B. The Birth of the Right of Publicity

Fifty years after the right to privacy was planted, with the help of the Second Circuit, it bloomed into the right of publicity. In *Halean v. Topps Chewing Gum*,³¹ the plaintiff, a seller of chewing gum, contracted with a baseball player for the exclusive use of the player's photograph in connection with the selling of the plaintiff's product.³² The defendant, despite knowing of the existing contractual agreement, induced the same player into a similar contract for the promotion of the defendant's chewing gum.³³ The defendant maintained that the plaintiff could rely only upon the right of privacy, and that the right of privacy was exclusively a personal right and as such non-assignable.³⁴ The Second Circuit disagreed, and in so doing created the right of publicity.³⁵

statutes, the New York courts have "generally refused the many invitations offered them to recognize an independent right of publicity." Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 858 (1983).

29. Georgia was the first state to recognize a right to privacy: *Pavesich v. New England Life Ins., Co.*, 122 Ga. 190 (Ga. 1905). Within a few years fourteen others had done the same: Alabama, Arizona, California, Florida, Illinois, Indiana, Kansas, Kentucky, Michigan, Missouri, Montana, North Carolina, Oregon and Pennsylvania. Nimmer, *supra* note 17, at 203.

30. *Pavesich v. New England Life Ins., Co.*, 122 Ga. 190, 202 (Ga. 1905).

31. 202 F.2d 866 (2d Cir. 1953).

32. *Id.* at 867.

33. *Id.*

34. *Id.*

35. Interestingly, a 1960 article written by William Prosser has at times been misidentified as the source of the evolution of the right of publicity from the right to privacy. See, e.g., *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 409 (2001) ("The common law right of publicity derives from the fourth category of invasion of privacy identified by Dean Prosser. . ."). Prosser's article, which essentially codified the

We think that, in addition to and independent of that right of privacy... a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i.e.,³⁶ without an accompanying transfer of a business or anything else.

Then speaking only for himself and one of his fellow panelists,³⁷ Judge Frank wrote:

This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their picture.³⁸

The issue was remanded for more fact finding,³⁹ but the wheels set in motion by Judge Frank continue to turn today. The first and perhaps still most significant scholarly analysis of *Halean* was written one year later by Melville Nimmer.⁴⁰ Nimmer, who later wrote the nation's foremost copyright treatise,⁴¹ fleshed out Judge Frank's one paragraph sketch, and defined the new right as the "reverse side of the coin of privacy."⁴²

right of privacy into four separate but interconnected torts, was published six years after Nimmer's article and seven years after the *Halean* decision. William Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960). The four torts were: Unreasonable intrusions upon another's solitude; Public disclosure of embarrassing private facts; Publicly placing another in a false light; and the Appropriation for the defendant's advantage of the plaintiff's name or likeness. *Id.*

36. *Halean*, 202 F.2d at 868.

37. Chief Judge Swan concurred with the holding but did not seem to endorse Judge Frank's creation of this new 'right,' only going so far as to concur with the part of the decision dealing with "defendant's liability for intentionally inducing a ball-player to breach a contract which gave plaintiff the exclusive privilege of using his picture." *Id.* at 869.

38. *Id.* at 868. From the very first, the Second Circuit and the New York Courts have been at odds interpreting New York's right to privacy statute in regards to the right of publicity. In *Halean*, Judge Frank explicitly holds that New York's right to privacy statute "recognizes" such a right of publicity for prominent persons. *Id.* But see note 28 (describing New York's rejection of a common law right of publicity).

39. *Id.* at 870.

40. It was appropriately entitled *The Right of Publicity*. Nimmer, *supra* note 17.

41. See MELVILLE NIMMER, NIMMER ON COPYRIGHT: A TREATISE ON THE LAW OF LITERARY, MUSICAL AND ARTISTIC PROPERTY, AND THE PROTECTION OF IDEAS (Dec. 2003).

42. Nimmer, *supra* note 17, at 204.

Nimmer recognized that there had been an explosion in the means of communication and advertising not only since the Brandeis and Warren article, but since the right to privacy had become so commonly part of the legal vernacular.⁴³ The concerns of many plaintiffs were no longer centered on preserving their privacy, but on maximizing the monetary value of their public persona.⁴⁴ After outlining what he termed the “inadequac[ies] of traditional legal theories in protecting publicity values,”⁴⁵ Nimmer offered some policy justifications for such a right, arguing that “in most instances a person achieves publicity values of substantial pecuniary worth only after he has expended considerable time, effort, skill, and even money.”⁴⁶ He argued that the right of publicity should mimic property rights, and therefore be assignable.⁴⁷

Nimmer posited that the measure of damages should be based not on the insult to the plaintiff, but on the “value of the publicity appropriated by the defendant.”⁴⁸ Though an in-depth discussion of damages for an appropriation of the right of publicity is beyond the scope of this article, Nimmer’s proposal that damages be based not on mental anguish but on pecuniary loss has been the prevailing view of scholars.⁴⁹ Furthermore, such a basis for damages appears to capture

43. *Id.* at 203-04.

44. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 204 (1954). Nimmer refers to this value as “publicity value.” *Id.*

“Persona” has been defined as “encompass[ing] a use where a viewing audience is merely reminded of a person even when neither the likeness nor the name of the person is used.” Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 205 (2002), citing *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284 (9th Cir. 1999) (Kozinski, J., dissenting) (objecting to denial of rehearing en banc); Rothman uses the copyright idea/expression dichotomy to argue that persona should be conceived of as the idea of a person not the expression, in other words, not the individual’s name or likeness. *Id.* at 223; Black’s Law Dictionary defines persona as “A person; an individual human being.” BLACK’S LAW DICTIONARY 1163 (7th ed. 1999).

45. Nimmer, *supra* note 44.

46. *Id.* at 216.

47. *Id.*

48. *Id.*

49. See Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 854 (1995) (noting that celebrities have a right for economic damages as a result of the appropriation without permission of their persona); Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994) (advocating a damage analysis sounding in damages after the act of appropriation); Maar, *supra* note 23, at 866-67. But see Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 133 (1993) (arguing that “[p]ublicity rights are about meaning as well as money.”).

Judge Frank's concern when he described the "sorely deprived" celebrity in *Halean*.⁵⁰

II. Justifications

While the right to privacy was first imagined as a method for protecting citizens from the "outrageous and unjustifiable infliction of mental distress" by the press of the nineteenth century,⁵¹ justifications for the right of publicity have varied. Economic incentive, moral, and fairness theories have all been propounded to validate the doctrine.⁵² One commentator has noted that celebrities generate so much "economic value" that entire industries have grown up around the culture of celebrity, and hence need protection.⁵³ For others the right of publicity is justified by its prevention of unjust enrichment, otherwise known as "free riding."⁵⁴ This concept is often expanded from the individual to society at large by the "tragedy of the commons" theory.⁵⁵ Put another way, it has been argued that the right of publicity is "needed to ensure that publicity assets are not wasted by a scramble to use them up as quickly as possible."⁵⁶ Others have argued from a more philosophical standpoint, suggesting that

50. *Halean*, 202 F.2d at 868.

51. Prosser, *supra* note 35, at 384.

52. See *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 834 (1979) (Bird, C.J. dissenting) (explaining the right by writing: "Often considerable money, time and energy are needed to develop one's prominence in a particular field. Years of labor may be required before one's skill, reputation, notoriety or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion."); Tara B. Mulrooney, *A Critical Examination of New York's Right of Publicity Claim*, 74 ST. JOHN'S L. REV. 1139, 1143-44 (2000) ("The justifications . . . fall into three main categories: (1) the moral argument for the recognition of such a right, (2) economic concerns, and (3) public interest concerns. The moral argument focuses mainly on the failure of privacy laws to adequately address the plaintiff's harm."); Christopher Pesce, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782, 792-93 (1990) ("The right serves to prevent the unjust enrichment of commercial appropriators, to provide an incentive to creators, and to protect the public from deception. It creates a kind of intellectual property that benefits the public by stimulating creative acts.").

53. See Madow, *supra* note 49, at 129 (detailing some of the variety of ways that celebrities are vital to the economy: the news stories revolving around celebrities; the merchandise with celebrity names and/or images on them; celebrity endorsements of products and services). However, Professor Madow advocates the elimination of the right of publicity. *Id.* at 134.

54. Mark F. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 U.C.L.A. ENT. L. REV. 97, 109 (1994).

55. See Garrett Hardin, *The Tragedy of the Commons*, 162 SCI. 1243 (1968) (generally describing the theory).

56. Grady, *supra* note 54, at 98.

individuals “ought to have control over how their personas are presented to others.”⁵⁷

In the first and only United States Supreme Court opinion to address the right of publicity, the Court relied on a mix of justifications, citing both moral and economic rationales for the right. In *Zacchini v. Scripps Howard Broadcasting Co.*,⁵⁸ Hugo Zacchini, a human cannonball artist, brought a tort action for the “unlawful appropriation of [his] professional property” against the operator of a local television station.⁵⁹ The defendant broadcast Mr. Zacchini’s entire act on a local news show.⁶⁰ The Supreme Court of Ohio reviewed the case under the right of publicity.⁶¹ Though the state’s highest court declared that “one may not use for his own benefit the name or likeness of another, whether or not the use or benefit is a commercial one,”⁶² the Ohio court held on behalf of the news station because the station had a “privilege to report . . . matters of legitimate public interest.”⁶³

The United States Supreme Court reversed the judgment.⁶⁴ While both courts relied on the First Amendment in reaching their respective decisions,⁶⁵ the high court determined that “[w]herever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer’s entire act without his consent.”⁶⁶ Nonetheless, the court recognized that Zacchini’s “state-law right of publicity would not serve to prevent [Scripps Howard] from reporting the newsworthy facts about [the] act.”⁶⁷ In other words, while there is a newsworthy/public interest exception to the right of publicity, the

57. J. Eugene Salomon, Jr., Note, *The Right of Publicity Run Riot: The Case for a Federal Statute*, 60 S. CAL. L. REV. 1179, 1190 (1987) (detailing the “personhood” theory).

58. 433 U.S. 562 (1977).

59. *Id.* at 563-64. The entire act, in which Zacchini is shot out of a cannon into a net, lasts fifteen seconds. *Id.* at 563.

60. *Id.* at 563-64.

61. *Id.* at 565.

62. *Id.*

63. *Id.*, quoting *Zachinni v. Scripps Howard Broadcasting Co.*, 351 N.E.2d 454, 461 (1976).

64. 433 U.S. at 579.

65. *Id.* at 568.

66. *Id.* at 574-75. See Samuelson, *supra* note 28, at 858 n.81 (noting that the resultant ‘entire act’ standard may be so narrow as to prevent its usefulness in other cases).

67. *Zacchini*, 433 U.S. at 574.

actions of the defendant in this situation went beyond such an exception.

Justice White, writing for the majority, used a variety of reasons to justify why the right of publicity is worth protecting. He began by addressing the economic interest of both the plaintiff and society at large: the "State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of an individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation."⁶⁸ The Court added that such protection creates "an economic incentive" for the performer to "make the investment required to produce a performance of interest to the public . . . the encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and the useful Arts.'"⁶⁹

The Court also spoke to the free rider rationale, writing: "[n]o social purpose is served by having the defendant get some free aspect of the plaintiff that would have market value and for which he would normally pay."⁷⁰ A Labor Theory justification (sometimes known as a "natural right to reap what you have sown") crept into the Court's reasoning as well: "Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered."⁷¹ The Court concluded by recognizing the right of Ohio (and all the states) to determine how or if it wishes to protect the economic interests of entertainers.⁷²

Secondly, the Court addressed the confluence of the right of publicity and the First Amendment:

There is no doubt that entertainment, as well as news, enjoys First Amendment protection. It is also true that entertainment itself can be important news. But it is important to note that neither the public nor [broadcaster] will be deprived of the benefit of [an entertainer's] performance as long as his commercial stake in his act is appropriately recognized.⁷³

68. *Id.* at 573.

69. *Id.* at 576, *quoting* *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

70. *Id.*

71. *Id.*, *quoting* *Mazer v. Stein*, 347 U.S. 201, 219 (1954). Nimmer, *supra* note 17, at 216 (justifying one of the "principle[s] of Anglo-American jurisprudence . . . that every person is entitled to the fruit of his labors . . ."). Another commentator has made the argument in even starker terms: "Proprietary justice demands that 'he who reaps shall sow.'" SAMUEL K. MURUMBA, *COMMERCIAL EXPLOITATION OF PERSONALITY* 72 (1986).

72. *Zacchini*, 433 U.S. at 577.

73. *Id.* at 578 (internal citations omitted).

The Court's narrow holding has left the door open for a wide range of interpretations regarding both the rationale for the right of publicity and how it should interact with the First Amendment.

One of the most complete and detailed interpretations is by Professor Alice Haemmerli.⁷⁴ Professor Haemmerli argues that what is needed is a justification based on the philosophy not of John Locke, but of Immanuel Kant.⁷⁵ Haemmerli dissects the standard justifications for the right of publicity one by one, detailing either how they encourage conflicting standards of review or offer inadequate reasons for granting the existing protections.⁷⁶ By reorienting the "sweat of the brow" underpinnings that have existed from the beginnings of the right of publicity, Haemmerli takes a bold step forward, stating "there is no 'Lockean' notion here of property rights acquired through labor."⁷⁷ Explaining that Kant believed that "the modification of a thing by labor 'forms nothing more than an external sign of the fact that it has been taken into possession,'"⁷⁸ she puts forward a new model. Advocating a "property right based on human freedom,"⁷⁹ she explains that according to Kant:

there is an underlying self; that while there is a difference between the self and objectification (or commodification) of self, the latter does not negate the former (indeed, it derives from the former); that a property right which provides for control over objectification of identity is not logically opposed to an autonomy right that protects the self; and that the two can, in fact, be viewed as two facets of freedom. What this means in reality is that even in the presence of commodification, a viable claim can be made to control the commercial exploitation of identity on *both moral and economic grounds*.⁸⁰

However, the most convincing justification for the right of publicity may be the most obvious: it simply feels as if there should be one. One hundred years ago, Judge Cobb, in justifying the right to privacy wrote:

The knowledge that one's features and form are being used . . . and displayed in . . . advertisements . . . brings not only the person of an extremely sensitive nature, but even the individual of ordinary sensibility, to a realization that his liberty has been taken away from him; and, as long as the advertiser uses him for these

74. Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383 (1999).

75. *Id.* at 383.

76. *Id.* at 390.

77. *Id.* at 421.

78. *Id.*

79. *Id.* at 429.

80. *Id.* at 427-28 (emphasis added).

purposes, he cannot be otherwise than conscious of the fact that he is, for the time being under the control of another, that he is no longer free, and that he is in reality a slave, without hope of freedom, held to service by a merciless master; and if a man of true instincts, or even of ordinary sensibilities, no one can be more conscious of his complete enthrallment than he is.⁸¹

Although Judge Cobb was referring to a violation of an individual's privacy, no great leap is necessary to read the right of publicity directly into his reasoning. Our "persona" is "ours." And while some scholars and practitioners have suggested a federal publicity statute separate from either trademark or copyright law,⁸² and others wish to create a registration system "akin to copyright and trademark,"⁸³ currently the most important issue facing the right of publicity is how to balance it with the First Amendment.

The lack of a clearly defined test for analyzing right of publicity cases where the First Amendment is implicated leaves open the possibility of widely varying and inconsistent holdings. One jurist has even expressed concern that the right of publicity is a threat to the existence of free speech, and objected that the right of publicity "created an open-ended and ill-defined force which jeopardizes a right of unquestioned authenticity—free speech."⁸⁴ One practitioner has summed up the opposite view by arguing that to "give absolute protection to expressive works is to eliminate the right of publicity."⁸⁵ The current lack of a "principled and consistent method of resolving the conflict between the right of publicity and the First Amendment" has resulted in "massive confusion."⁸⁶ Recognizing that the right of publicity is not going away,⁸⁷ and neither is the First Amendment, a consistent manner of analyzing the many cases that intersect these two vital doctrines must be developed. The remainder of this article attempts to create just such a test.

81. *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 220 (1905).

82. See, e.g., *Salomon*, *supra* note 57, at 1191-93 (suggesting that while the Copyright Clause might otherwise be appropriate, as a publicity statute would go beyond 'writings,' the Copyright Clause might prove limiting and therefore ineffective).

83. *Robinson*, *supra* note 11, at 204.

84. *Martin Luther King, Jr., Ctr. For Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 708 (Ga. 1982) (Welter, J., concurring).

85. *Moore*, *supra* note 12, at 5.

86. *Kwall*, *supra* note 49, at 47-48.

87. Though some may argue that it should, see *Madow*, *supra* note 49.

III. Step One: The Newsworthy/Public Interest Exception

A. Expression

The First Amendment protects expression. The Restatement of Unfair Competition refers to the First Amendment's commitment to freedom of expression;⁸⁸ a United States Supreme Court Justice has argued that freedom of speech *is* individual self-expression;⁸⁹ one observer has discussed the "expressive rights embodied in the First Amendment;"⁹⁰ and a recent Amici brief on behalf of professional journalists has demanded that the right of publicity be curtailed so as not to limit the "expressive activity protected by the First Amendment."⁹¹ With such a consensus, one approach to dealing with the First Amendment and the right of publicity might be to ask a single question: Is the work expressive? After all, an expressive test would seem entirely appropriate if all concerned agreed with the premise that the central tension is that the "right of publicity's restriction on the unauthorized commercial use of one's identity prohibits certain forms of expression . . . therefore . . . conflict[ing] with the freedom of speech the First Amendment seeks to protect."⁹² Thus, if the work is expressive, it is protected by the First Amendment, otherwise, the plaintiff wins.

However, while the United States Supreme Court has elucidated a fairly clear line between commercial and noncommercial speech,⁹³ the Court has created no such standard for what constitutes expressive speech. In fact, it has been argued that *Zacchini* provides little guidance when "applied to a case other than the appropriation of a professional or . . . performer's performance."⁹⁴ It has also been recently noted that a "three-way split of authority" exists for how to resolve the tension between the right of publicity and the First

88. Restatement (Third) of Unfair Competition, § 47 cmt. c. (2003).

89. First Nat'l Bank v. Bellotti, 435 U.S. 765, 804, 807 (1978) (White, J., dissenting).

90. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 479 (2003).

91. Amici Curiae Brief of The Reporters Committee for Freedom of the Press and the Society of Professional Journalists in Support of Defendant/Appellee Jireh Publishing, ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915 (6th Cir. 2003) (No. 00-3584).

92. Maar, *supra* note 23, at 871.

93. See Part IV.B.

94. F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against a Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1, 44 (2003).

Amendment's interest in protecting expressive works.⁹⁵ In other words, courts have been unable to establish exactly what is expressive and therefore unreachable by the right of publicity.

Before directly exploring the newsworthy/public interest exception, it is informative to examine two cases with opposite holdings to demonstrate exactly how difficult it is to define expressive. Less than a year after *Zacchini*, *Playgirl* magazine published a drawing of a nude black man bearing a striking resemblance to Muhammad Ali seated in the corner of a boxing ring with the caption "Mystery Man."⁹⁶ Despite the figure not being named, a verse appears in conjunction with the drawing "which refers to the figure as 'the Greatest'."⁹⁷

While it is unlikely that anyone wishes to be depicted in the nude without permission, even when such a depiction is a fictitious one (there is no indication that the drawing was based in reality), such an artist's rendering at first blush would seem to fit under the ambit of protection of the First Amendment. After all, it is in a magazine, albeit one that is not known for art, yet, one covered by the freedom of the press all the same.

Nevertheless, relying on the pecuniary value of Muhammad Ali's "public reputation or persona"⁹⁸ and that the "interest underlying the right of publicity is the 'straightforward one of preventing unjust enrichment by the theft of goodwill'"⁹⁹ the court held Ali had met the criteria for making out a common law right of publicity claim in New York. The district court specifically held that the drawing was not newsworthy, but rather a "dramatization, an illustration falling somewhere between representational art and cartoon, and is accompanied by a plainly fictional and allegedly libelous bit of doggerel."¹⁰⁰ The court's holding and its use of the terms "dramatization" and "fictional" seem incongruous with another

95. Moore, *supra* note 12, at 4 (referring to the newsworthy, transformative and predominant purpose tests, all discussed *infra*).

96. Ali v. Playgirl, 447 F. Supp. 723, 727 (S.D.N.Y. 1978).

97. *Id.*, "The Greatest" was a moniker that both the plaintiff and the press often used when referring to Muhammad Ali, the former heavyweight boxing champion of the world. *Id.*

98. *Id.* at 728.

99. *Id.* at 728-29, quoting *Zacchini v. Scripps Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977).

100. *Id.* at 727. It is unclear what exactly the "verse" the court refers to was, as such it is hard to draw any specific conclusions from the description of it as "doggerel."

Southern District Court of New York's decision ten years later in another right of publicity case.¹⁰¹

In *Rogers v. Grimaldi*,¹⁰² film star Ginger Rogers sought relief under the right of publicity for the use of her name and public personality in the film "Ginger and Fred."¹⁰³ The film by internationally acclaimed director Federico Fellini told the story of two retired dancers who had "made a living in Italian cabarets imitating Ginger Rogers and Fred Astaire, thus earning the nickname 'Ginger and Fred.'"¹⁰⁴ Throwing up the First Amendment as a shield, the defendants claimed the plaintiff's charges were precluded by the First Amendment and that the film's references to Rogers, both in the title and the film itself, were protected as artistic expression.¹⁰⁵ The court, reviewing other right of publicity cases, stated that "[c]ourts have been consistently unwilling to recognize the right of publicity cause of action where the plaintiff's name or picture was used in connection with a matter of public interest, be it news or entertainment."¹⁰⁶ Such reasoning being used in the same district as the court that produced the *Ali* decision appears inconsistent to say the least.

In *Rogers*, the court granted summary judgment for the defendants.¹⁰⁷ Explaining that it is well settled that:

[W]orks of fiction are constitutionally protected in the same manner as political treatises and topical news stories . . . What may be difficult to communicate or understand when factually reported

101. It is interesting to observe that the United States Supreme Court a mere ten years after *Ali* held for *Hustler Magazine*, when it ran an advertisement parody intimating that the Reverend Jerry Falwell's first sexual experience was a "drunken incestuous rendezvous with his mother in an outhouse." *Hustler Magazine v. Falwell*, 485 U.S. 46, 48 (1988). There are of course significant differences between *Falwell* and *Ali*. The plaintiff in *Falwell* brought his action based on libel, slander and intentional infliction of emotional distress, not the right of publicity and the court's holding was on the basis of the parody being in the style of a political cartoon. *Id.*

Nevertheless, it is not difficult to argue that *Hustler's* parody of Falwell was as damaging if not more so than *Playgirl's* caricature of Ali. In fact, it is the Court's language in *Falwell* that is directly relevant: "The fact that society may find speech offensive is not a sufficient reason for suppressing it. Indeed, if it is the speaker's opinion that gives offense, that consequence is a reason for according it constitutional protection." *Id.* at 55 (internal citations omitted). And, "[i]t is firmly settled that . . . the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers." *Id.* at 56 (internal citations omitted).

102. 695 F. Supp. 112 (S.D.N.Y. 1988).

103. *Id.* at 113, 115.

104. *Id.* at 114.

105. *Id.* at 121.

106. *Id.* at 116.

107. *Id.* at 113.

may be poignant and powerful if offered in satire, science fiction or parable [S]ince Rogers and Astaire are . . . part of the cultural history of an era,¹⁰⁸ their fame is an equally apt topic for Fellini's fictional work.

The court concluded that since the plaintiff did not argue the film lacked a creative component, there must be a creative component and therefore the "use of [her] name is not primarily for a commercial purpose."¹⁰⁹ This conclusion is an excellent example of why an expressive or creative test would be unworkable. It is hard to imagine a better way to chill free speech and engender a complete lack of reliability in judicial holdings than to let judges determine on motions of law what is or is not expressive or creative. As Justice Holmes wrote "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."¹¹⁰ Concomitantly, as *Ali* and *Rogers* demonstrate, to allow the entire decision of whether one's right of publicity has been appropriated to rest on an individual judge's vision of newsworthiness, is an insufficient means of making such a determination.

B. Commercial Speech

The above discussion makes clear that a different approach to right of publicity actions where the First Amendment is implicated is needed. Yet, a brief investigation into the flip side of expressive speech, 'commercial speech,' is necessary before going any further. One commentator has opined that commercial speech is actually just a term for speech that "looks more like a non-expressive product than like speech."¹¹¹

The United States Supreme Court has defined commercial speech as speech that "does no more than propose a commercial transaction."¹¹² Such speech must also generally be "truthful" and "non-misleading."¹¹³ In fact the Supreme Court has created a test to determine if a law regulating commercial speech is acceptable. Usually referred to as the *Central Hudson*¹¹⁴ test, it holds that only

108. *Id.* at 123 (citations omitted).

109. *Id.* at 124.

110. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

111. Dougherty, *supra* note 94, at 8.

112. *Virginia Pharmacy Bd. v. Virginia Citizens Consumer Council, Inc.* 425 U.S. 748, 762 (1976).

113. *Lee*, *supra* note 90, at 476.

114. *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n.* 447 U.S. 557 (1980).

commercial speech that is “false, deceptive or misleading . . . may be banned.”¹¹⁵ Therefore, speech that has been deemed to be commercial is still due First Amendment protection,¹¹⁶ just at a lower level of scrutiny than noncommercial speech.¹¹⁷

However, from its beginnings the right of publicity has been a right “to control the *commercial* use of . . . identity.”¹¹⁸ Put another way, it has always been about money, and the exploitation of one’s own persona or identity for the purpose of profit. Hence, right of publicity cases, almost per se, involve speech that in some form is commercial.¹¹⁹ As Judge Frank wrote in *Halean*, “[w]hether it be labeled a ‘property’ right is immaterial; for here, as often elsewhere, the tag ‘property’ simply symbolizes the fact that courts enforce a claim which has pecuniary worth.”¹²⁰ If there were no pecuniary worth involved, it is highly unlikely that a painter would want to appropriate Tiger Woods’ image.¹²¹ Therefore, a simple determination that a use of celebrity’s persona is commercial speech is unlikely to be a consistent method of deciding right of publicity actions.

As one district court recognized when it granted injunctive relief for a group of rock star plaintiffs for the use of their likenesses on buttons, the purpose of the right of publicity is “to protect the commercial value acquired by names and likenesses due to investments of time, energy, money, and talent.”¹²² The same court held there was a “‘proprietary interest’ in the commercial value of one’s persona” and as such it was assignable and licensable.¹²³

115. *Id.* at 566. The state must show that a “restriction directly and materially advances a substantial state interest in a manner no more extensive than necessary to serve that interest” in order to restrict speech that is not false, deceptive or misleading. *Ibanez v. Florida Dept. of Bus. & Prof’l Regulation*, 512 U.S. 136, 142 (1994).

116. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 68-69 (1985).

117. *Id.* at 65.

118. *McCarthy*, *supra* note 7, § 1:3 (emphasis added).

119. It is important to note that even a not-for-profit use can still yield speech that has a pecuniary effect *on the celebrity*. One might imagine a true story or real image posted for free on the internet that produces a detrimental result to a celebrity’s endorsement ability. In such an instance the newsworthy/public interest component of the right of publicity would likely apply. See Part IV.C. The celebrity might well choose to pursue an injunction nonetheless.

120. *Halean v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

121. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003). The same could be said about Bette Midler’s voice and Ford (Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988)); or Johnny Carson’s name and Here’s Johnny Portable Toilets (Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983)); and many others.

122. *Bi-Rite Ent., Inc. v. Button Master*, 555 F. Supp. 1188, 1199 (S.D.N.Y. 1983).

123. *Id.*

It is this issue of the pecuniary value *to the plaintiff* where one proponent of the elimination of the right of publicity fails to see that the right is always commercial.¹²⁴ Professor Madow stakes his theory on the idea that celebrities essentially are a part of the common language to which individuals within society make a contribution and therefore we should be able to comment and use this part of our culture as we each individually see fit.¹²⁵ Regardless of the accuracy of the theory of cultural contribution to celebrity, it leads Madow to speculate that “[o]nce a celebrity has developed or acquired a commercially valuable identity, others can use or appropriate it at a cost that is close to zero.”¹²⁶ Yet, Madow neglects to mention that such use is only at no cost to the public. It is at least possible, if not probable, that the pecuniary interest held by a celebrity will be decreased, perhaps eliminated, by a free riding populace unchecked by any right of publicity.

Assuming that the right of publicity is almost always in some form commercial, courts are faced with one of two choices when a defendant raises a First Amendment defense. Either the defendant’s use is protected because it is expressive¹²⁷ and strictly noncommercial speech is per se unassailable, or courts will proceed to an examination of the newsworthiness or public interest of the use. In either case, making a determination that the speech is commercial is not always necessary, and even when performed, often not decisive in right of publicity cases.

C. The Exception

A good starting point for the newsworthy/public interest exception¹²⁸ portion of the four factor test is § 47 of the Restatement

124. Madow, *supra* note 49.

125. *Id.* at 132-34.

126. *Id.* at 222, n.445.

127. As far as can be understood from the published opinion, the defendant in *Ali* never raised a noncommercial speech First Amendment defense, relying instead on the newsworthiness of the drawing. *Ali v. Playgirl*, 447 F. Supp. 723 (S.D.N.Y. 1978).

One author argues that “where it is obvious that the defendant’s work is fiction the First Amendment argument should generally outweigh whatever contextual or moral objections a plaintiff may raise.” Kwall, *supra* note 49, at 104. Such an argument only works if one agrees that fiction falls under the public interest and as such should be protected. Hence, the issue of how to treat fictional works falls under the newsworthy/public interest section of the herein described test as well.

128. It is vital to note that this is only step one of a multi-faceted test. If the newsworthy/public interest exception were the only element to be used, it too would fail for many of the same reasons that an expressive or entire act test would fail.

of Unfair Competition. Section 47 addresses the right of publicity and is entitled "Use for Purposes of Trade."¹²⁹ It reads:

The name, likeness, and other indicia of a person's identity are used 'for purposes of trade' under the rule stated in § 46 if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use 'for purposes of trade' does not ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.¹³⁰

Comment "c" to the Restatement states that the "right of publicity [that] is recognized by statute and common law is fundamentally constrained by public and constitutional interest in freedom of expression."¹³¹ This is the newsworthy/public interest exception. The California right of publicity statute, one of the broadest in the nation for protecting the rights of plaintiffs, was the statute chosen by the Restatement to use as a model code.¹³² Its newsworthy/public interest exception states in relevant part: "[f]or purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required"¹³³

Beginning with *Zacchini*, courts have generally cast a wide net when discussing newsworthiness. "There is no doubt that entertainment as well as news enjoys First Amendment protection. It is also true that entertainment itself can be important news."¹³⁴ In *Ann-Margret v. High Society Magazine, Inc.*,¹³⁵ a district court held that the publication of nude pictures of the plaintiff captured from a film in which she willingly performed in the nude were newsworthy.¹³⁶ The court held that "the scope of what constitutes a newsworthy event has been afforded a broad definition and held to include even

129. Restatement (Third) of Unfair Competition § 47 (2003).

130. *Id.*

131. *Id.* at § 47 cmt. c.

132. Stephen R. Barnett, *First Amendment Limits on the Right of Publicity*, 30 TORTS & INS. L.J. 635, 637 (1995) ("The Restatement, in stating a black-letter rule protecting the celebrity's 'identity,' . . . and in other provisions, has opted almost completely for the California Approach in preference to New York's.").

133. CAL. CIV. CODE § 3344(d) (2003).

134. *Zacchini v. Scripps Howard Broadcasting Co.*, 433 U.S. 562, 578 (1977).

135. 498 F. Supp. 401 (S.D.N.Y. 1980).

136. *Id.* at 405.

matters of entertainment and amusement, concerning interesting phases of human activity in general.”¹³⁷

Another example of a court invoking the newsworthy exception was in *Stephano v. News Group*.¹³⁸ In *Stephano*, the plaintiff, a fashion model, brought an action against the publisher of New York Magazine on grounds that his right of publicity had been violated.¹³⁹ The defendant had used the same picture of the plaintiff in two separate issues of the magazine.¹⁴⁰ The second use was for an article titled “Best Bets” for the year in fashion.¹⁴¹ The plaintiff claimed that he had only agreed to, and been compensated for, one use of the picture.¹⁴² Accordingly, he alleged the defendant had (in the language of the statute) used “his photograph for trade or advertising purposes without his consent.”¹⁴³ The Appellate Division¹⁴⁴ rejected the defendant’s affirmative defense of “newsworthiness,”¹⁴⁵ finding that it was “possible that this article constituted an advertisement in disguise since many of the Magazine’s advertisers were mentioned in the copy,” and remanded for further factual examination.¹⁴⁶

The Court of Appeals overturned the decision, and held that the article fell under the rubric of public interest.¹⁴⁷ The Court explained that “a picture illustrating an article on a matter of public interest is

137. *Id.* (internal quotations omitted).

138. 64 N.Y.2d 174 (N.Y. 1984). The *Stephano* decision is a landmark one in New York right of publicity law, as it is the holding where the court rejected the Second Circuit’s reasoning that a common law right of publicity separate from the statutory right of privacy existed in New York. MCCARTHY, *supra* note 7, at § 6:78.

Reading a broadness into the language of the statute unlike its predecessors, the Court of Appeals of New York held that the New York right of privacy “statute applies to any use of a person’s picture or portrait for advertising or trade purposes whenever the defendant has not obtained the person’s written consent to do so.” 64 N.Y.2d at 183 (emphasis added). Therefore, the statute applies to an instance where a plaintiff “generally seeks publicity” but “has not given written consent for a particular use.” *Id.* Hence, the court opened the door to right of publicity actions under the rubric of the right to privacy statute. Yet, by so doing, the court closed the door on plaintiffs bringing such an action outside of New York Civil Rights Law §§ 50, 51, and required that such actions be brought under the statute. *Id.* This action eliminated a thirty-year history of a distinct and progressive common law right of publicity in New York.

139. *Id.* at 180.

140. *Id.* at 179.

141. *Id.*

142. *Id.* at 180.

143. *Id.*

144. *Stephano v. News Group Pub., Inc.* 98 A.D. 2d 287 (N.Y. App. Div. 1984).

145. “A collateral question is presented as to whether the article’s newsworthiness was merely incidental to the commercial purpose of the article.” *Id.* at 292.

146. *Id.* at 291.

147. *Stephano v. News Group Pub., Inc.*, 64 N.Y.2d 174, 184-85 (N.Y. 1984).

not considered used for the purposes of trade or advertising within the prohibition of the statute unless it has no real relationship to the article, or unless the article is an advertisement in disguise.”¹⁴⁸ Holding that “[t]he newsworthiness exception applies not only to reports of political happenings and social trends but also to news stories and articles of consumer interest including developments in the fashion world,”¹⁴⁹ the court found the article was not an advertisement in disguise because fashion trends can fit within a liberally applied newsworthiness exception.

The Court of Appeals’ emphasis on a “liberal” application of the newsworthy/public interest exception tips the scale in favor of defendants in right of publicity actions. The Supreme Court of New York’s decision in *Welch v. Group W. Productions*¹⁵⁰ demonstrates the breadth of the *Stephano* holding. The court rejected a plaintiff’s right of publicity claim that his image had been used in an unauthorized fashion in an award show for commercials.¹⁵¹ The court wrote: “It has been held that these terms (the language of the New York statute) should not be construed to include newsworthy events or matters of interest, which include not only political happenings and social events but also articles of interest to consumer groups and fashion events.”¹⁵²

Then, expanding on what content falls into the newsworthy category, “[n]ot only the existence of an article of commerce, but its availability at a particular place, and even its price, may be considered newsworthy to special groups.”¹⁵³ Concluding with a clear refutation of the plaintiff’s argument that the only reason his picture was being used was to make money (hence falling outside the scope of the exception), the court held that a desire to profit does not automatically remove an activity’s newsworthiness: “That the television segment was motivated by the desire of the defendants to increase their profits does not convert a newsworthy article or

148. *Id.* at 185.

149. *Id.* at 184.

150. 138 Misc. 2d 856, 858 (N.Y. Sup. Ct. 1987).

151. *Id.* Plaintiff had appeared in a commercial which was awarded an award. Plaintiff claimed his picture was being used without his written consent for the purposes of advertising or trade by the company which produced the award show. *Id.* at 858.

152. *Id.* at 860.

153. *Id.* The court’s broad language seems to presage the California Supreme Court: “Newsworthiness is not limited to ‘news’ in the narrow sense of reports of current events. It extends also to the use of names, likenesses or facts in giving information to the public for purposes of education, amusement or enlightenment, when the public may reasonably be expected to have a legitimate interest in what is published.” *Shulman v. Group W. Prod., Inc.*, 18 Cal. 4th 200, 225 (Cal. 1998).

television show into a trade purpose, since it is the *content of the material which determines whether it is newsworthy*.”¹⁵⁴

Fortunately for celebrities the holdings of the New York courts have not entirely occupied the field. A 1983 California Court of Appeals encountered a defendant improperly invoking the newsworthy exception. In *Eastwood v. Superior Court*¹⁵⁵ the film star sued the National Enquirer for what he labeled a false article.¹⁵⁶ Eastwood was victorious on all counts as the court held “that Eastwood has sufficiently alleged that the Enquirer has commercially exploited his name, photograph, and likeness under both the common law and § 3344(a).”¹⁵⁷ Grounding its holding in § 3344(d),¹⁵⁸ the court ruled there was no statutory newsworthy exception for a story that was false and presented as true.¹⁵⁹ Deciding that the “deliberate fictionalization of Eastwood’s personality constitutes commercial exploitation, and becomes actionable when it is presented to the reader as if true with the requisite scienter,”¹⁶⁰ the court held for the plaintiff. The court did not speak to the consequences if the defendant had *not* had the required level of scienter, yet still published a false or misleading story. One would imagine under *Central Hudson*¹⁶¹ such a story might still be actionable.

In *Downing v. Abercrombie & Fitch*,¹⁶² the Ninth Circuit reversed a trial court holding for the defendants and remanded for trial.¹⁶³ Defendant, a popular clothing outfitter, used a picture of the plaintiffs surfing in a competition in 1965 in Hawaii in its Spring Quarterly subscription catalog, which is the defendant’s “largest advertising vehicle.”¹⁶⁴ The theme of the catalog was “Spring Fever” and featured a section entitled “Surf Nekkid” which included a 700-word story

154. 138 Misc. 2d 856, 860 (N.Y. Sup. Ct. 1998) (emphasis added).

155. *Eastwood v. Super. Ct. of L.A. County*, 149 Cal. App. 3d 409, 420 (1983).

156. *Id.* at 421.

157. *Id.* at 421. § 3344 is California’s right of publicity statute. CAL. CIV. CODE § 3344 (2003).

158. CAL. CIV. CODE § 3344(d) (2003) (California’s newsworthy/public interest exception).

159. 149 Cal. App. 3d at 413.

160. *Id.* at 426.

161. 447 U.S. 557 (1986).

162. 265 F.3d 994 (9th Cir. 2001).

163. *Id.* at 999.

164. *Id.* at 999-1000.

about the history of surfing at a particular beach in California. The picture of the plaintiffs appeared on the following page.¹⁶⁵

Using the surf theme, the defendants manufactured and advertised T-shirts in the Spring Quarterly that looked exactly like the shirts worn by the plaintiffs in the pictures.¹⁶⁶ The court, while recognizing the existence of a broad newsworthy exception, firmly laid out limits to the defense: "the defense is not absolute; we must find a proper accommodation between the competing concerns of freedom of speech and the right of publicity."¹⁶⁷

The Ninth Circuit compared *Downing* with an earlier surfing-right of publicity case decided in state court in California, *Dora v. Frontline Video*.¹⁶⁸ In *Dora* the plaintiff sought damages for the "unauthorized use of his name, voice, and likeness."¹⁶⁹ The plaintiff, Mickey Dora, was known as a local surfing legend in the 1950s. The defendant found video footage of the plaintiff surfing and included it in a video documentary chronicling the beginnings of surfing at Malibu.¹⁷⁰ Citing the newsworthy/public interest exception in its holding for the defendant, the California Court of Appeals concluded that:

Though both celebrities and noncelebrities have the right to be free from the unauthorized exploitation of their names and likenesses, every publication of someone's name or likeness does not give rise to an appropriation action. Publication of matters in the public interest, which rests on the right of the public to know and the freedom of the press to tell it, is not ordinarily actionable.¹⁷¹

The *Downing* panel contrasted Mickey Dora's contribution to the development of the sport of surfing, which was the "point of the program" in *Dora*, to the plaintiffs being used as "essentially window dressing to advance the catalog's surf theme" in *Downing*.¹⁷² Accordingly, the Ninth Circuit held that Abercrombie & Fitch's use

165. *Id.* at 1000 (It should be reiterated that the picture of the plaintiffs was not taken in California, but in Hawaii).

166. *Id.* The pages directly following the pictures of the plaintiffs advertised the shirts.
Id.

167. *Id.* at 1001 (internal quotations omitted).

168. 15 Cal. App. 4th 536 (1993).

169. *Id.* at 540.

170. *Id.*

171. *Id.* at 542. The court held the documentary "contains matters of public interest and that the respondent was not required to obtain appellant's consent to use his name, likeness, and voice in the program."

172. 265 F.3d at 1002.

was not entitled to First Amendment protection as it was more commercial than newsworthy or in the public interest.¹⁷³

The newsworthy/public interest exception cases analyzed above seem to follow a relatively predictable pattern: any use that may be of interest even to a small select group,¹⁷⁴ or is true,¹⁷⁵ or is creative,¹⁷⁶ without being entirely exploitative¹⁷⁷ will be held to be newsworthy or in the public interest.¹⁷⁸ The final two cases to be surveyed in this section present almost identical fact patterns yet yield opposite results. It is just such an outcome that the four factor test is designed to avoid.

In *Grant v. Esquire, Inc.*,¹⁷⁹ Esquire magazine republished a photograph of film star Cary Grant in 1971 that it had previously published in 1946.¹⁸⁰ Grant's picture was one of six that the defendant altered, using the celebrity's heads but substituting a model's body for everything below the neck to make it appear as if the celebrities were wearing clothes from 1971.¹⁸¹ The brand name and price of the sweater worn by "Grant" in the 1971 picture was listed beneath the photograph.¹⁸² Grant brought a right of publicity complaint under New York's common law, which Esquire claimed was barred by the First Amendment.¹⁸³ The court analyzed both the statutory and common law claims simultaneously and found that while "as a matter of law the article on its face does not constitute an advertisement," Grant's face was being used for the "purposes of trade."¹⁸⁴

Not having the luxury of the *Zacchini* decision, the court reviewed New York decisions on the right of publicity where the First Amendment was implicated and observed that the trend skewed

173. 265 F.3d 994, 1002 (9th Cir. 2001).

174. *Stephano v. News Group Publications, Inc.*, 64 N.Y.2d 174 (N.Y. 1984); *Welch v. Group W. Prods.*, 138 Misc.2d 856 (N.Y. Sup. Ct. 1987).

175. *Dora v. Frontline Video*, 15 Cal. App. 4th 536 (1993); *Ann Margret v. High Society Magazine, Inc.*, 498 F. Supp. 401 (S.D.N.Y. 1980).

176. *Rogers v. Grimaldi*, 695 F. Supp. 112 (S.D.N.Y. 1988).

177. *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

178. *Ali* would appear as an outlier to this rule which is why it was included, to demonstrate the inconsistent body of common law that has developed with regards to the question at hand. *Ali v. Playgirl*, 447 F.Supp. 723 (S.D.N.Y. 1978).

179. 367 F. Supp. 876 (S.D.N.Y. 1973).

180. *Id.* at 877.

181. *Id.* at 878.

182. *Id.*

183. *Id.* The plaintiff also brought a libel complaint which was summarily dismissed and a right of privacy action under the New York Civil Rights Law § 51. *Id.*

184. *Id.* at 879.

towards defendants in these types of actions.¹⁸⁵ Nonetheless, the court compares the plaintiff's situation with that of a celebrity that pursues the limelight and exploits her image successfully.¹⁸⁶ The court reasons that a picture taken of such a celebrity while she is out on the town and then published would be a use of which she could not complain. However, "it by no means follows that publishers could present [her] apparently posed . . . and without her consent use [such a picture] in competition with other pictures for which she had professionally posed. . . ." ¹⁸⁷

The court reasons: "[a] fortiori, no magazine could without her consent crop her head off a posed photograph and superimpose it on the torso of another model."¹⁸⁸ The court concludes that Cary Grant should not be thought of any differently because he has not pursued the exploitation of his image. "If the owner of Blackacre decides for reasons of his own not to use his land but to keep it in reserve he is not precluded from prosecuting trespassers."¹⁸⁹ Simply put, the court held the defendant exploited the plaintiff's image "merely to attract attention."¹⁹⁰

The district court, addressing the possibility that a holding for Grant would be barred by the First Amendment stated:

One must never lose sight of the purpose behind the decisions implementing the First Amendment. The Supreme Court does not closely scrutinize restraints on obscenity because it feels that obscene literature is any boon to mankind. On the contrary, it scrutinizes such restraints solely because it feels that the concept of obscenity is so vague that unless rigorously circumscribed the fear of obscenity prosecution might inhibit the free expression of artistic talent.¹⁹¹

Furthermore, the court speaking to future publishers, writes that if a publisher "feels impelled to trade upon the name and reputation of a celebrity, it must pay the going rate for such benefit."¹⁹² The court finishes by noting that a painter could not go out and steal the

185. 367 F.Supp. 876, 879 (S.D.N.Y. 1973). The court cites five cases all but one of which "denied recovery under § 51, for the reason that in each the court held the plaintiff's picture to have been 'reasonably related' to a newsworthy subject and thus its use not to have been 'for purposes of trade' within the meaning of § 51." *Id.*

186. *Id.* at 880. The court uses Leslie Hornby, also known as "Twiggy" for its example.

187. *Id.* (punctuation omitted)

188. *Id.*

189. *Id.*

190. *Id.* at 881.

191. *Grant v. Esquire, Inc.*, 367 F.Supp. 876, 882 (S.D.N.Y. 1973).

192. *Id.* at 883.

materials it needs for its work, and neither can a publisher.¹⁹³ The court's opinion appears well reasoned, logical and an appropriate application of the newsworthy/public interest exception test. Nevertheless, thirty years after the publication of Grant's picture, another magazine did almost the exact same thing.

In *Hoffman v. Capital Cities/ABC Inc.*¹⁹⁴ Los Angeles Magazine ran a series of pictures of famous film stars entitled "Grand Illusions" which via computer alteration made it look like the film stars were wearing "Spring 1997" fashions.¹⁹⁵ One of the sixteen altered photos was of Dustin Hoffman from the film "Tootsie," in which he plays a cross-dressing man.¹⁹⁶ The altered picture was a still photo where Hoffman's body had been changed for that of a male model wearing a different dress than the one worn in the film.¹⁹⁷ The defendant did not receive permission for such an alteration from either Hoffman or the copyright holder of the film and Hoffman brought a right of publicity action arguing his name and likeness had been appropriated.¹⁹⁸ Not surprisingly, the defendant argued the picture was part of "an expression of editorial opinion, entitled" to First Amendment protection.¹⁹⁹

Hoffman argued that because the photograph identified the names of the designers of the clothes the model was wearing, the speech was purely commercial.²⁰⁰ The Ninth Circuit was not convinced. "Viewed in context, the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors. Any commercial aspects are inextricably entwined with expressive elements, and so they cannot be separated out from the fully protected whole."²⁰¹ The district court, much as the *Grant* court did, reasoned that the only

193. *Id.* "[N]obody would seriously contend that artistic need would authorize a painter to walk into a supply store and help himself to whatever he might require." *Id.*

194. 255 F.3d 1180 (9th Cir. 2001) (Capital Cities was Los Angeles Magazine's parent company).

195. *Id.* at 1182-83. Interestingly one of the actors used in the piece was Cary Grant from the movie "North by Northwest." *Id.* at 1183. It does not appear that Mr. Grant's estate brought an action against the defendant.

196. *Id.* at 1182-83.

197. *Id.* The new caption read: "Dustin Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels." *Id.* at 1183.

198. *Id.* at 1183.

199. *Id.* at 1184. It is of note that the district court held for Hoffman under the theory that the photograph was false speech and therefore not protectable. *Id.*

200. *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001)

201. *Id.* (internal quotations omitted).

purpose for Hoffman's image to be used was to "attract attention" to the magazine.²⁰² The appeals court reversed the decision, using an unorthodox line of reasoning.

The panel held that a "printed article meant to draw attention to the for-profit magazine in which it appears, however, does not fall outside of the protection of the First Amendment because it may help to sell copies."²⁰³ Though in and of itself this is not an unusual argument, the court follows by finding that not only was the speech protected it was "not commercial speech."²⁰⁴ While the court acknowledges that there was testimony that the "issue and the use of celebrities was intended in part to 'rev up' the magazine's profile, that does not make the fashion article a purely 'commercial' form of expression."²⁰⁵

Though it would not be hard to see the creative elements needed to produce the article, that the court leapt from the speech not being "purely commercial" to it being essentially expressive, and therefore exempt from review is a tough argument to reconcile. As one commentator observed, the court "spent surprisingly little time discussing how it should evaluate the magazine's conduct."²⁰⁶ Between the use of the designer's names, a buyer's guide in the back of the magazine listing the prices and stores where one could find the items worn by the plaintiff,²⁰⁷ and the testimony that the point of the article was to rev up the profile of the publication, it is hard to agree that the article had *no* commercial components to it. In finding for the defendant without invoking the newsworthy/public interest exception the court makes its holding one on which it is difficult to rely.²⁰⁸ One sure sign of this unreliability is that one practitioner in summarizing the case has essentially been forced to guess at the court's reasoning for its decision, writing: "[a]lthough the court did not state the basis for First Amendment protection, the only logical basis was that the photograph qualified as an expressive work."²⁰⁹

202. Hoffman v. Capital Cities/ABC Inc., 33 F. Supp. 2d 867, 874-75 (C.D. Cal. 1999) ("Moreover, the use of Mr. Hoffman's name and likeness was wholly unnecessary to deliver whatever message Defendant, Los Angeles Magazine, Inc., claims the *Los Angeles Magazine* article contained").

203. Hoffman v. Capital Cities/ABC Inc., 253 F.3d at 1186.

204. *Id.*

205. *Id.*

206. Lee, *supra* note 90, at 495.

207. Hoffman v. Capital Cities/ABC Inc., 253 F.3d at 1185.

208. Perhaps most surprising was that neither the district court nor the Ninth Circuit cited *Grant v. Esquire, Inc.*, 367 F.Supp. 876 (S.D.N.Y. 1973).

209. Moore, *supra* note 12, at 4.

It is an inconsistent holding like *Hoffman* that led to the development of the four factor test. It is clear that when a court applies the exception with an eye towards the type of uses in *Eastwood* or *Downing*, the exception will fail. However, it is holdings like *Hoffman* or *Stephano*, where a court could reasonably find that there was a newsworthy exception, but a plaintiff's right to publicity was nevertheless being misappropriated, that the below test is intended to address. These types of holdings are the reason why the newsworthy/public interest exception is only the starting place for determining the outcome of right of publicity cases implicating the First Amendment, and not the finish line.

IV. The Four Factor Test

A. Overview

Each factor of the following test is designed to be utilized only after a holding that the defendant's use of the plaintiff's name, persona or likeness, is newsworthy or in the public interest.²¹⁰ The four factors are: Does the use *evoke* the image or persona of the plaintiff? Is the use *related* to the plaintiff's public persona? Is the use an *advertisement in disguise*? Are *alternate means* of conveying the defendant's message available? An answer of "no" to any of the four factors should result in an automatic holding for the defendant.²¹¹ While no single element carries more weight than any other, each should be examined in the order presented. If all questions are answered in the positive, the plaintiff's right of publicity is a strong one, despite the First Amendment test of newsworthiness. Though it may appear harsh for a defendant to succeed with a single 'no,' while the plaintiff will only have the opportunity to succeed after securing four positive answers, this is for good reason. The right of publicity is inherently one that rewards the few over the many. For a plaintiff to successfully stop dissemination of an "idea" or "art," the standard should be high.

210. If a defendant were to invoke a First Amendment newsworthiness defense and fail to convince a court of the public interest of the use, it would be difficult for the defendant to win his or her case.

211. For example in addressing the first element, if a use was found not to evoke the image or persona of the plaintiff, clearly his or her right of publicity is not being violated.

B. Does the Use Evoke the Image or Persona of the Plaintiff?

While the question of whether a plaintiff's persona or image has been evoked in the use in question may at first appear to be a simple one, at times it has been the crux of the issue in a right of publicity action. The most infamous such action is *White v. Samsung*.²¹² In *White*, the plaintiff, famous for her role as the hostess of the television game show "Wheel of Fortune," claimed the defendant had appropriated, without her consent, her identity by imitating her with a robot in a commercial.²¹³ The defendant on the other hand claimed two separate First Amendment defenses.²¹⁴ First, that the ad was a parody and, in the alternative, that the ad was based on a "'generic' game show hostess and not on Vanna White."²¹⁵

The Ninth Circuit was not swayed by either defense. The court held the use involved a "true advertisement run for the purpose of selling Samsung VCRs . . . [and] [t]he ad's spoof of Van White . . . is subservient and only tangentially related to the ad's primary message."²¹⁶ As to the second argument the court wrote: "for celebrity exploitation advertising to be effective, the advertisement must evoke the celebrity's identity. The more effective the evocation, the better the advertisement."²¹⁷ The court explained that it could enforce a right of publicity where neither the plaintiff's name, photograph, likeness or voice had been 'used:' because since "Prosser's early formulation, the case law has borne out his insight that the right of publicity is not limited to appropriation of name or likeness."²¹⁸

The Ninth Circuit's holding and subsequent decision to deny an en banc rehearing evoked a "vigorous,"²¹⁹ "stinging dissent."²²⁰ With what can only be described as incredulity, Judge Alex Kozinski assesses the results of *White*:

Under the majority's opinion, it's now a tort for advertisers to remind the public of a celebrity. Not to use a celebrity's name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity's image in the public's mind. This Orwellian notion withdraws far more from the public

212. 971 F.2d 1395 (9th Cir. 1992).

213. *Id.* at 1396-97.

214. *Id.* at 1401.

215. *Id.*

216. *Id.*

217. *Id.*

218. *White v. Samsung*, 971 F.2d 1395, 1398 (9th Cir. 1992).

219. Marr, *supra* note 23, at 882.

220. MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B] (1994).

domain than prudence and common sense allow. It conflicts with the Copyright Act and the Copyright Clause. It raises serious First Amendment problems . . .²²¹

This decision has led one commentator to note that as the “actual name or likeness of the person need not be used, right of publicity holders can monopolize abstractions and reminders about themselves and the characters that they play. Ultimately, the use of “persona” allows people to protect the idea of themselves rather than the concrete expression of their name and likeness.”²²² There is no question that in many cases, reminding the public of the celebrity is the entire intent of the advertisement to begin with. The holding in *White* delivers a strong weapon into the hands of celebrity plaintiffs when encountering advertisers. Yet, Judge Kozinski argues that it goes beyond advertisers, threatening the First Amendment itself: “[t]he intellectual property right created by the panel . . . has no fair use exception; no right to parody; no idea-expression dichotomy. It impoverishes the public domain, to the detriment of future creators and the public at large.”²²³ Questioning the majority’s entire First Amendment rationale, he writes that the “First Amendment isn’t just about religion or politics—it’s also about protecting the free development of our national culture.”²²⁴

In *White*, the majority cites a case that does not touch specifically on the First Amendment but is an excellent example of whether the image of the plaintiff being evoked is used as a threshold question. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*,²²⁵ the defendant used an altered photograph of the plaintiff’s racing car for a cigarette advertisement.²²⁶ The alterations made to the car did not remove some of the telltale signs that it was the plaintiff’s vehicle, and “[s]everal of the plaintiff’s affiants who saw the commercial on television had immediately recognized plaintiff’s car and had inferred that it was sponsored by Winston cigarettes.”²²⁷ Hence, there was little

221. *White v. Samsung*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting) (objecting to denial of rehearing en banc).

222. Rothman, *supra* note 44, at 222-23. Rothman argues that this protection of the “idea of oneself” is in direct opposition to Copyright law. *Id.*

223. *White v. Samsung*, 989 F.2d at 1516.

224. *Id.* at 1519. Kozinski also chastises the majority for holding that because Samsung’s speech was commercial it was due no protection, writing that “less protection means protected nonetheless.” *Id.* at 1519-20.

225. 498 F.2d 821 (9th Cir. 1974).

226. *Id.* at 822. That the plaintiff was driving the vehicle was determined via the pleadings as his “facial features” are not visible in the picture. *Id.*

227. *Id.* Another example of evocativeness being a key issue is *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) where the plaintiff won

question that the plaintiff persona was being evoked by the advertisement.

The test recommended here is not the stringent standard of *White*, but rather the rational factual exploration undertaken in *Motschenbacher*. It appears clear that under the *White* holding it would be difficult *not* to evoke the image of a given celebrity. Yet, as previously stated, advertisers and artists will generally choose a method of representation to at least produce some passing evocation of the celebrity in question. Hence, *Motschenbacher* is a good middle ground. First, the plaintiff was in the car. Second, despite altering the car, plaintiff's fans believed he was in the car. It should be clear that evoking the plaintiff is a low standard to meet, but it is an important one nonetheless.

C. Is the Use Related to the Plaintiff's Public Persona?

The Copyright Act of 1976²²⁸ contains a fair use exception. Codified as a four part test,²²⁹ the purpose is to provide a "privilege to use copyright material in a way that otherwise would be a violation of the copyright monopoly."²³⁰ Commentators and courts alike have struggled with the application of the copyright fair use factors to the right of publicity. One authority has stated that to use the "copyright fair use framework in cases presenting a conflict between the First Amendment and the right of publicity is inappropriate."²³¹ Another notes that the "fair use doctrine, nevertheless, is the most clearly articulated approach to reconciling property and speech interests in the intellectual property field."²³² Yet, the same author also observes that this "does not mean [using fair use factors] is popular or [that their] application is predictable."²³³

injunctive relief for the use of his name to evoke his persona on behalf of a portable toilet company with which the plaintiff had no affiliation.

228. 17 U.S.C. § 101 (2004).

229. The four factors making up the copyright "fair use" test are: 1. the purpose and character of the use; 2. the nature of the copyrighted work; 3. the amount and substantiality of the portion used; 4. the effect of the use upon the potential market for or value of the copyrighted work. 17 U.S.C. § 107 (2004).

230. Douglas J. Ellis, *The Right of Publicity and the First Amendment: A Comment on Why Celebrity Parodies are Fair Game for Fair Use*, 64 U. CIN. L. REV. 575, 599 (1996).

231. Kwall, *supra* note 49, at 58. Professor Kwall "confesses" that she has previously written that the copyright fair use factors were the "appropriate means" to balance the competing interests, but has since reconsidered. *Id.* at 58 n.54.

232. Lee, *supra* note 90, at 481-82.

233. *Id.* at 482.

Nevertheless, one influential court has appropriated a portion of the doctrine to craft its own test for examining the right of publicity and the First Amendment. In *Comedy III Prods., Inc. v. Saderup, Inc.*²³⁴ the California Supreme Court created a balancing test for determining whether a use of a celebrity's persona is new and somehow different and hence transformative, and therefore protected. In creating its test, the court rejected "a wholesale importation of the fair use doctrine,"²³⁵ and selected only the "purpose and character of the use"²³⁶ factor as being "particularly pertinent to the task of reconciling the rights of free expression and publicity."²³⁷

Part two of the four factor test borrows from the *Comedy III* court's reasoning and asks: is the use in question related to the plaintiff's public persona? Put another way, what is the purpose of the use of the plaintiff's persona? The need for this portion of the test is demonstrated in the varied holdings of the following cases.

In *Montana v. San Jose Mercury News, Inc.*²³⁸ the California Court of Appeals held for a newspaper in its use of Joe Montana's image in a poster. Montana, the famed quarterback for the San Francisco Forty Niners, claimed his right of publicity was violated by the defendant's sale of an artist's rendering of Montana celebrating his victory in Super Bowl XXIII, in poster form.²³⁹ The court reasoned that "[B]ecause Montana's name and likeness appeared in the posters for *precisely* the same reason they appeared on the original newspaper front pages [i.e.,] because Montana was a major player in contemporaneous newsworthy sports events . . . [his] claim that [the defendant] used his face and name solely to extract the commercial value from them fails."²⁴⁰

It is exactly this type of fact pattern that brings Professor Madow to question the need for a right of publicity. Posing a hypothetical question regarding the incentive argument, he asks: "will Quarterback Brown give up professional football and his multimillion

234. *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387 (2001). The *Comedy III* decision and the court's transformative test are discussed in Part VI.

235. *Id.* at 404.

236. 17 U.S.C. § 107(1) (2004).

237. 25 Cal. 4th at 404.

238. 34 Cal. App. 4th 790 (1995).

239. *Id.* at 792-93. The rendering had been on the front page of the newspaper the day after the game. Montana conceded that such use was newsworthy. His complaint was based on the reproduction for resale in poster form. *Id.* at 794.

240. *Id.* (emphasis in original).

dollar salary if others are free to use his picture on posters or T-shirts without paying him for the privilege?"²⁴¹ Yet such an argument misses the point entirely. In *Montana*, the court held that because the original use of the rendering was newsworthy, the subsequent commercial use was also newsworthy.²⁴² This holding allowed the court to skirt the incentive argument completely.

In *Paulsen v. Personality Posters, Inc.*,²⁴³ a comedian's attempt to enjoin a poster marketer from selling posters of him with the phrase "For President" on it failed on First Amendment grounds. The trial court held that Paulsen had no right of publicity claim because he had conducted a "mock campaign for the presidency" and therefore a poster "which portrays [the] plaintiff in that role . . . is a form of public interest presentation to which protection must be extended."²⁴⁴ The *Paulsen* holding was grounded in the plaintiff having thrust himself into the:

[N]ational political scene, a sphere which is itself always "newsworthy" and which propels into such category all, irrespective of prior status, who aspire to participate therein. It is, moreover, an arena whose participants have traditionally been the fairest of all game for unbridled, unrestrained public comment and criticism ranging from the ridiculous to the scurrilous. Limitations upon the permissible in political expression are almost nonexistent. It is the strength of our political system that it can survive and flourish in such matrix, where the sensibilities of the participants must bow to the superior public interest in completely unfettered and unabridged free discussion of whatever persuasion, merit or style.²⁴⁵

The holding was based on the speech being political. Obviously, no such claim was relevant to Joe Montana's action.

A pair of New York cases decided after *Zacchini* should have helped the *Montana* court: *Factors, Etc., Inc. v. Creative Card Co.*²⁴⁶ and *Factors Etc., Inc. v. Pro Arts, Inc.*²⁴⁷ Both found the representatives of Elvis Presley's estate arguing that memorabilia with "The King" on it was a misappropriation of his right of publicity. The estate won both times. In the former, the court rejected a newsworthy defense by the poster's maker, holding: "there is no constitutional protection for selling posters of Elvis Presley as Elvis

241. Madow, *supra* note 49, at 210. Madow answers his own question, "not likely." *Id.*

242. *Montana*, 34 Cal. App. 4th at 794.

243. 299 N.Y.S.2d 501 (Sup. Ct. N.Y. 1968).

244. *Id.* at 506, 507.

245. *Id.* at 507.

246. 444 F. Supp. 279 (S.D.N.Y. 1977).

247. 579 F.2d 215 (2d Cir. 1978).

Presley.”²⁴⁸ The latter decision found that a poster with the phrase “In Memory 1935-1977” did not make the use newsworthy.²⁴⁹ This decision has led one commentator to question why the “Joe Montana poster was Joe Montana as Joe Montana, yet found to be newsworthy. This ability to manipulate outcomes by conclusory categorizations is inadequate to protect freedom of speech.”²⁵⁰

It is exactly this lack of consistency that begs for clarification. Hence, the issue should be a simple one: is the use related to the public persona of the plaintiff? In all of the above cases, the answer is simple: yes. In such cases a court would now proceed to the third factor, the advertising in disguise question. However, an example of when the use is not that of the public persona is also worth examining.

In *Wendt v. Host Int'l*,²⁵¹ the plaintiffs, George Wendt and John Ratzenberger appealed a dismissal of their right of publicity claim to the Ninth Circuit. The defendants, via license had created “animatronic robotic figures” based on the characters played by the plaintiffs in the television show: “Cheers.”²⁵² The defendants placed the robots in airport bars “modeled after the set”²⁵³ of the show. The plaintiffs did “concede that they retain no rights to the characters Norm and Cliff . . . [yet argued it was] the physical likeness to [the plaintiffs], not Paramount’s characters, that has commercial value to [the defendant].”²⁵⁴

The district court held for the defendants, asserting that “no reasonable jury could find that the robots are similar in any manner whatsoever to Plaintiffs.”²⁵⁵ Yet, the Ninth Circuit “conclude[d] from [its] own inspection of the robots that material facts exist that might cause a reasonable jury to find them sufficiently ‘like’ the

248. 444 F. Supp. at 285.

249. 579 F.2d at 222.

250. Dougherty, *supra* note 94, at 15.

251. 125 F.3d 806 (9th Cir. 1997).

252. *Id.* at 809. Mr. Wendt played “Norm” and Mr. Ratzenberger played “Cliff.” *Id.* at 813.

253. *Id.*

254. *Id.* at 811. To the great disdain of commentators, the court held that the “[a]ppellants’ claims are not preempted by federal copyright law.” *Id.* at 810. See Michael J. Albano, *Nothing to Cheer About: A Call for Reform of the Right of Publicity in Audiovisual Characters*, 90 GEO. L.J. 253 (2001) (“The Ninth Circuit has continued to test the limits of the right of publicity, but its reasoning in this decision [Wendt] oversteps the bounds of logic.”); Johnson, *supra* note 11, at 186 (analyzing the *Wendt* decision, concluding: “Few circuit courts other than the Ninth Circuit have recognized such an expansive right of publicity. It is unlikely that animatronics reproduction claims would have much success in any other circuit.”).

255. *Wendt v. Host Int'l*, 125 F.3d at 810 (internal quotations omitted).

appellants”²⁵⁶ Regarding this article’s four factor test, it is important to make two points at this juncture. First, the plaintiffs in *Wendt* were in danger of failing the first test: is the use evocative? This is clearly a tougher question when the issue is the portrayal of fictional characters by real people. Yet it is an even tougher question when the facts indicate that the question is: Does a portrayal of fictional characters played by real people by robots violate a right of publicity? Obviously, the Ninth Circuit believes the answer is yes, based on its holdings in both *White* and *Wendt*.

In response to the difficulty of such a situation, when the evocative question is one that cannot be easily answered, the next element concerns the type of use at hand: is the use related to the plaintiff’s public persona? The obvious point that must be made is that *no one would want a robot of George Wendt portraying George Wendt*. The commercial exploitation by Host is of a fictional character that George Wendt portrayed. The Ninth Circuit cites the California Supreme Court in *Lugosi v. Universal Pictures*, explaining “an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character.”²⁵⁷ Yet, there were serious questions in *Wendt* as to whether either plaintiff’s likeness was actually being exploited. The district court held there was “no similarity at all” between the plaintiffs and the robots.²⁵⁸

The answer to the second factor as applied to *Wendt* should have been: no. The robots were placed in a bar setting by Host International, not by coincidence, but because the robots were representative of the copyrighted characters, owned by Paramount Pictures and licensed to Host International. “Norm” and “Cliff” were characters from a show set in a bar, and the characters, particularly Norm, were in large part famous for sitting on bar stools.²⁵⁹ Dissenting, Judge Kozinski wrote: “[w]hen portraying a character who was portrayed by an actor, it is impossible to recreate the character without evoking the image of the actor in the minds of

256. *Id.*

257. *Id.* at 811 (citing *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 823 (1979)). *Lugosi* saw the heirs of the late Bela Lugosi bring a right of publicity action against Universal for exploiting Lugosi’s portrayal of Dracula. *Id.*

258. *Id.* at 812. In fact, after the defendant failed to receive permission from the plaintiffs as to the use of their likenesses, the robots were “altered cosmetically” and renamed “Hank and Bob.” *Id.* at 813.

259. *Wendt v. Host Int’l*, 197 F.3d 1284, 1285 (9th Cir. 1999) (Kozinski, J., dissenting) (objecting to denial of rehearing en banc).

viewers.”²⁶⁰ Assailing the ruling as contrary to the law of copyright, he continued: “[a]t the very least, Paramount must be able to reproduce the characteristics that bring Norm and Cliff to mind.”²⁶¹ Finding it difficult to imagine an instance where a celebrity would not win this type of case, Judge Kozinski wrote: “*White* exploded the right of publicity to include anything that brings the celebrity to mind.”²⁶² Though it appears reasonable minds could disagree, if the trier of fact found that the robots bore no similarity to the plaintiffs, their claim must fail.

D. Is the Use an Advertisement in Disguise?

In *Stephano*, the Court of Appeals of New York held for the defendant New York Magazine in part based on an infrequently used test in right of publicity cases: is the use “an advertisement in disguise?”²⁶³ Another way to ask this question is: Does the use have “no real relationship to the article?”²⁶⁴ This element of the four factor test may be the most difficult for a court to determine as a question of law. After all, just like trying to show in a trademark case that a consumer was truly “confused,”²⁶⁵ to conclusively prove that a use of a plaintiff’s persona though possibly newsworthy is nonetheless an advertisement in disguise will clearly be difficult, but should by no means be impossible.

In *Robinson v. Snapple Beverage Corp.*,²⁶⁶ a district court held that the “Sugar Hill Gang,” a rap group, had had its image wrongfully

260. *Id.* at 1286.

261. *Id.* In the same dissent Kozinski wrote: “As I predicted, *White*’s voracious logic swallows up rights conferred by Congress under the Copyright Act.” *Id.* at 1285. “It’s inevitable that so broad and ill-defined a property right will trench on the rights of the copyright holder.” *Id.* at 1286.

Another commentator regarded the *Wendt* decision with even more dread, writing that if “*Wendt* is any indication of which direction this area of law is headed, then the future appears bleak for federal copyright holders.” Albano, *supra* note 254, at 263. The author even attacks the moral labor theory justification of the Ninth Circuit’s decision. Arguing that the robots “bore none of the facial features of the actors who portrayed the characters . . . because the actor’s primary contribution in this context lies with [his] physical likeness, and because that contribution is not explicitly used despite the Ninth Circuit’s attempts to reason otherwise, the notion that the actor should be given a publicity right to protect her contribution is all but eliminated.” *Id.* at 281. Albano suggests moving to a pure work for hire agreement system. *Id.* at 278-80.

262. *Id.*

263. *Stephano v. News Group Pub. Inc.*, 64 N.Y.2d 174, 185 (1984).

264. *Id.*

265. Trademark law “promotes the designation of a source as a method of preventing consumer confusion and encouraging quality control.” Maar, *supra* note 23, at 875.

266. 2000 U.S. Dist. LEXIS 8534, at *1 (S.D.N.Y. June 19, 2000).

used for advertising purposes in violation of the group members' right of publicity, amongst other claims. The defendant used video footage of the group performing at an event sponsored by the defendant to promote another event sponsored by the defendant's product in a commercial for the product and for the event.²⁶⁷ The court quickly dismisses the defendant's attempt to invoke the public interest defense: "[w]hile the Games are certainly newsworthy and a matter of public interest, the vignette . . . is clearly a solicitation of patronage for the Games. The public interest exemption does not apply when something is 'an advertisement in disguise.' Here, the Court is unable to even find a disguise."²⁶⁸ The court concludes by citing a right of privacy case where a plaintiff was victorious on the grounds that her picture was used without permission in a calendar that was seen to be a promotional vehicle for the defendant: "defendants cannot escape liability by attempting to 'wrap their advertising message in the cloak of public interest . . .'"²⁶⁹

Does the third element of the test work in a situation such as *Hoffman*? As mentioned above, determining if a use is an "advertisement in disguise" is a difficult task, yet use of the auxiliary phrase "no real relationship to the use" can be helpful. In *Hoffman*, the actor was not only placed in a dress other than the one worn in the film, but the clothes were identified by the brand name: "Dustin Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels."²⁷⁰ While there is no doubt a convincing argument could be made for parody, a just as convincing argument could be made that this caption reads like an advertisement in a fashion magazine.²⁷¹ Unfortunately for plaintiffs this is not an easy line to draw, and the third element will only prove helpful to celebrities in obvious situations.

Such a situation emerged in *Abdul-Jabbar v. GMC*.²⁷² The Ninth Circuit held for the former basketball star against the defendant car company for using Kareem Abdul-Jabbar's given name ("Lew

267. *Id.* at 2-4. The product was Snapple, the second event was the 'Goodwill Games,' an event mimicking the Olympics. *Id.*

268. *Id.* at 13 (citation omitted).

269. *Id.* at 13, quoting *Beverly v. Choices Women's Medical Ctr., Inc.*, 579 N.Y.2d 637, 641 (N.Y. 1991).

270. *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d at 1103.

271. Of course one might debate, is it an advertisement in disguise for Richard Tyler and Ralph Lauren or L.A. Magazine?

272. 85 F.3d 407 (9th Cir. 1996).

Alcindor”) in a trivia question in ‘an Oldsmobile commercial.’²⁷³ Despite Abdul-Jabbar having legally changed his name in 1971 for religious reasons, the court refused to rule that he had “abandoned” it and renounced all claims to future exploitation of it.²⁷⁴ Stating that “the appearance of an ‘endorsement’ is not the *sine qua non* of a claim for commercial appropriation,”²⁷⁵ the court went out of its way to explain that even though Abdul-Jabbar no longer used his given name, it was still identified with him for commercial purposes.²⁷⁶ The defense argued that its use of the name was exempt under the California statutory newsworthy exception.²⁷⁷ This was dismissed out of hand by the Court, stating that “[w]hile Lew Alcindor’s basketball record may be said to be ‘newsworthy,’ its use is not automatically privileged. GMC used the information in the context of an automobile advertisement, not in a news or sports account.”²⁷⁸ With courts having held commercials for commercial award shows newsworthy,²⁷⁹ naked pictures newsworthy,²⁸⁰ and computer-generated “makeovers” newsworthy,²⁸¹ one certainly could not blame GMC for thinking its use of a complimentary fact about an athlete was going to be seen as newsworthy.²⁸²

This matter would appear to be more easily determinable by asking the third question of the four factor test: is the use an advertisement in disguise?²⁸³ Oddly enough the likely answer is: no.

273. *Id.* at 409.

274. *Id.* at 411-12.

275. *Id.* at 414.

276. *Id.* at 412. The Court did hold that whether “Lew Alcindor” equals “Abdul Jabbar” in the way in which the cartoon in *Ali* labeled “the Greatest” equaled Muhammed Ali, or the robot in *White* equaled Vanna White, was a factual question. *Id.* at 416.

277. *Id.*

278. *Id.*

279. *Welch v. Group W. Prods. Inc.*, 138 Misc. 2d 856 (N.Y. Sup. Ct. 1987).

280. *Ann-Margret v. High Society Magazine, Inc.*, 498 F. Supp. 401 (S.D.N.Y. 1980).

281. *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d at 1180.

282. *Abdul-Jabbar v. GMC*, 85 F.3d at 415.

283. The commercial in question: A disembodied voice asks, “How ‘bout some trivia?” This question is followed by the appearance of a screen bearing the printed words, “You’re Talking to the Champ.” The voice then asks, “Who holds the record for being voted the most outstanding player of this tournament?” In the screen appear the printed words, “Lew Alcindor, UCLA, ‘67, ‘68, ‘69.” Next, the voice asks, “Has any car made the ‘Consumer Digest’s Best Buy’ list more than once? [and responds:] The Oldsmobile Eighty-Eight has.” A seven-second film clip of the automobile, with its price, follows. During the clip, the voice says, “In fact, it’s made that list three years in a row. And now you can get this Eighty-Eight special edition for just \$18,995.” At the end of the clip, a message appears in print on the screen: “A Definite First Round Pick,” accompanied by

Though Abdul-Jabbar's name is used in a commercial, the use itself is not commercial, and he would fail to meet the third factor. The question asked in the commercial involves a sporting fact, a question of history, in other words something that can be looked up. The implication of the court's holding could be staggering.

Does such a ruling mean that a car company could not use a trivia question involving a living former United States President in an advertisement for a President's Day sale? After all, in this day and age, the former President could make out a common law claim of injury of lacking the ability to now endorse another car. He could then, under *Abdul-Jabbar*, bring a statutory claim as no "appearance of endorsement" is necessary. Furthermore, under the Ninth Circuit reasoning, because the former President's name was used in an automobile advertisement and not in a "news" account, a newsworthy defense would not be available to the defendant either.²⁸⁴

E. Are Alternate Means of Conveying the Defendant's Message Available?

The fourth and final element of the four factor test once again borrows from the other intellectual property doctrines. Developed for use in both trademark and copyright actions, some courts have "adopted an 'alternative means of communication' test, pursuant to which non-commercial speech is held infringing if there is another way to convey the message without infringing intellectual property

the voice saying, "It's your money." A final printed message appears: "Demand Better, 88 by Oldsmobile." *Id.* at 409.

284. As it happens this is not a far-fetched scenario. See Madow, *supra* note 49, at n.262 (describing how in 1989, a cold medicine company used footage of Presidents Bush and Gorbachev with the tagline "In the New Year, may the only cold war in the world be the one we're fighting," without obtaining permission from either head of state. Two of the major United States networks refused to run the commercial.); *Two Networks Reject Ad*, Dec. 28, 1989 at A22, LEXIS News Library, File NYT (describing the past procedure of the White House in similar circumstances was to send "stiff cease and desist orders.").

Furthermore, see Eben Shapiro, *Rising Caution on Using Celebrity Images*, Nov. 4, 1992 at D20, LEXIS News Library, File NYT (discussing that Saddam Hussein's objection to use of his image in an unflattering manner in an advertisement for a provider of treasury bills, was successful in having the advertising agency use Joseph Stalin as a replacement). All of which leads to the question of has it always been like this? See LEO BRAUDY, *THE FRENZY OF RENOWN: FAME & ITS HISTORY* 452-53 (1986) (discussing mass publicity in the 1900s); Madow, *supra* note 49, at 150 ("[M]embers of the founding generation such as Washington, Adams, and Jefferson . . . suffered commercialization of their personas without apparent complaint.").

rights.”²⁸⁵ Specifically, this test has been used in the trademark and copyright context. In an action against the publishers of a book essentially using Dr. Seuss’s *Cat in the Hat* to tell a story about the O.J. Simpson murder trial,²⁸⁶ the court in determining the use was not allowed, explained: “[j]ust as in copyright, trademark infringement will be excused only where necessary to the purpose of the use. Where alternative means of achieving the satiric or parodic ends exist that would not entail consumer confusion, the First Amendment will not protect the parodist from being held to infringe.”²⁸⁷

Similarly, the United States Supreme Court, in drawing a distinction between parody and satire in the copyright context, gave parody a wide birth because it “needs to mimic an original to make its point,”²⁸⁸ unlike its counterpart, satire, which “can stand on its own two feet and so requires justification for the very act of borrowing.”²⁸⁹ In other words, the Court is reluctant to protect a satire that takes liberally from a single source, because there are alternate means of the author satirizing his or her subject.²⁹⁰ The fourth element of the four factor test proposes to use just such a test when analyzing rights of publicity actions where not only has the First Amendment been implicated, but the court has made a preliminary finding of newsworthiness. Remember, to even reach step four of the test, a plaintiff would have to successfully argue that her persona had been evoked, its use was related to her public persona, and the use was an advertisement in disguise.

One of the few right of publicity cases to utilize an alternative means test was *Cardtoons L.C. v. Major League Baseball Players Ass’n*.²⁹¹ Cardtoons created a set of parody baseball cards, using take-

285. Lee, *supra* note 90, at 482. Such a test has been used in determining if the title of an expressive work will be protected by the Eighth Circuit in *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987).

286. Dr. Seuss Enters., v. Penguin Books USA, Inc., 924 F. Supp. 1559 (S.D. Cal 1996), *aff’d* on other grounds, 109 F.3d 1394 (9th Cir. 1997) (Defendant’s book was entitled *The Cat Not in the Hat! A Parody by Dr. Juice*. The book was supposed “to supply a ‘fresh new look’ at the O.J. Simpson double-murder trial.” The book’s rhymes, illustrations, cover and packaging were described by the court as “mimic[ing] the distinctive style of the family of works created by Theodore S. Geisel, better known as Dr. Seuss.”). *Id.* at 1561.

287. *Id.* at 1573.

288. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580-81 (1994).

289. *Id.* at 581.

290. A standard example of such a distinction would be that while one could not effectively parody “Star Wars” without referencing “Darth Vader,” one could certainly satirize science fiction movies in general without having a character in a dark helmet who breathes through a mask.

291. 95 F.3d 959 (10th Cir. 1996).

offs on recognizable Major League Baseball players.²⁹² The MLBPA argued that the defendant had appropriated the players' right of publicity. The court disagreed.²⁹³ The defendants claimed a First Amendment defense, sounding in newsworthiness. The MLBPA countered that it should receive a lower standard of protection because it was printed on a nontraditional medium of expression.²⁹⁴

The plaintiff's contention meshes well with McCarthy's observation that "what is crucial" in right of publicity cases:

is the medium not the message. The courts have routinely denied First Amendment immunity from right of publicity liability when unpermitted use of identity is used even in 'messages' on T-shirts, dishes, ashtrays, drinking mugs and the like. The result is usually reached on the basis that these are not the usual media for social or political messages.²⁹⁵

Nonetheless, the Tenth Circuit protected the speech all the same. The court wrote that "[t]he protections afforded by the First Amendment . . . have never been limited to newspapers and books,"²⁹⁶ and found that because the plaintiff's "commentary is on an important social institution,"²⁹⁷ it was fully protected speech.

Yet, most significantly, the court holds that the plaintiffs' right of publicity action fails because:

Cardtoons' expression *requires* use of player identities because, in addition to parodying the institution of baseball, the cards also lampoon individual players. Further, Cardtoons' use of the trading card format is an *essential component of the parody* because baseball cards have traditionally been used to celebrate baseball players and their accomplishments. Cardtoons expresses ideas through the use of major league baseball player identities, and MLBPA's attempts to enjoin the parody thus goes to the content of the speech. . . .²⁹⁸

In other words, as to the fourth element, the plaintiff would lose in *Cardtoons*. But what about some of the above discussed cases?

The court in *Grant*, addressing the idea that its ruling for the plaintiff might chill free speech took judicial notice that: "there is no shortage of celebrities for an appropriate fee [who] are only too happy to lend their faces, names and reputations for exploitations in

292. *Id.* at 962-63. Barry Bonds became "Treasury Bonds;" Ken Griffey, Jr. became "Ken Spiffy, Jr." *Id.*

293. *Id.* at 962.

294. *Id.* at 969.

295. J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 7:6[A] (1996).

296. 95 F.3d at 969.

297. *Id.*

298. *Id.* at 971-72 (emphasis added).

such enterprises as the one here involved.”²⁹⁹ Putting aside for a moment the possibility that Cary Grant was specifically chosen for the article because he never would have agreed to it, the court’s conclusion has the feel of accuracy: “[t]here is no conceivable artistic or editorial purpose served by Mr. Grant’s picture that would not equally well have been served by any one of numerous other celebrities.”³⁰⁰ Though Grant might not have an easy time meeting the third element of the test, there is little question that he would be successful as to part four.

But what about Elvis?³⁰¹ It would be hard to commemorate his passing via an alternate means. Put another way, one cannot really tell the story of Elvis, without Elvis. Perhaps a more difficult example is Joe Montana. In *Montana*,³⁰² the plaintiff’s persona was used to commemorate the championship victory of his *team*. There are of course forty or more other players on the team, and then there are coaches, and team logos, etc. Yet, to use any individual player, the same right of publicity issue crops up. To use the team logo would bring the defendant into the land of trademark. And of course, Montana was the best known player on the team. Though it might be a jury question, it certainly appears as if it would be very difficult to convey the message of the San Francisco Forty Niners, in photographic form, winning Super Bowl XXIII without the use of Joe Montana.

However, the Court of Appeals of New York seemingly had a perfect opportunity to stop the use of a plaintiff’s persona, that was entirely optional in *Finger v. Omni Pubs., Int’l.*,³⁰³ and did not. The plaintiffs, who were not celebrities, brought an action under New York’s right of privacy statute against the publisher of Omni magazine.³⁰⁴ A picture of the plaintiff and his wife and their six children had been used as the cover picture in an article entitled “Caffeine and Fast Sperm.”³⁰⁵ The article was reporting on research

299. *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 883 (S.D.N.Y. 1973).

300. *Id.*

301. *See Factors, Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279 (S.D.N.Y. 1977); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *cert denied*, 440 U.S. 908 (1979).

302. *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790 (1995).

303. 77 N.Y.2d. 138 (NY 1990).

304. It should be noted that New York as of *Stephano* in 1984, does not recognize a right of publicity and hears all such cases under its Civil Rights Law §§ 50, 51. These laws lean closer to a right to privacy than to publicity. Oddly, this should have made the plaintiff’s case even stronger, but did not.

305. 77 N.Y.2d. at 140.

regarding the possible enhancement of in vitro fertilization rates by “exposing sperm to high concentrations of caffeine.”³⁰⁶ The caption beneath the picture was “Want a big family? Maybe your sperm needs a cup of Java in the morning. Tests reveal that caffeine-spritzed sperm swim faster, which may increase the chances for in vitro fertilization.”³⁰⁷ Amazingly, none of the plaintiff’s six children were conceived by in vitro fertilization.³⁰⁸ There was no mention in the article of the plaintiff or his family.³⁰⁹

The plaintiff’s claim, that his picture was being used without his consent “for advertising purposes or for the purpose of trade,” seems perfectly logical and the court appears to agree: “[w]e have repeatedly observed that the prohibitions of Civil Rights Law §§ 50 and 51 are to be strictly limited to nonconsensual commercial appropriation of the name, portrait or picture of a living person.”³¹⁰ Here, the plaintiff was living, he had not given his consent, and a magazine article with which he had no connection surely seemed to be commercial. However, the court used the newsworthy/public interest exception and denied the plaintiff’s claim that he had no real relationship to the article.³¹¹

The court opined that:

Clearly . . . there is a “real relationship” between the fertility theme of the article and the large family depicted in the photograph. That the article also discusses *in vitro* fertilization as being enhanced by “caffeine-spritzed sperm” does no more than discuss a specific aspect of fertilization and does not detract from the relationship between the photograph and the article.³¹²

The Second Circuit’s holding is very difficult to reconcile with common sense. What average individual would pick up a magazine with an article about in vitro fertilization, with a picture on the front page of a large family, and not make a connection between the two? As none of the plaintiffs were conceived via in vitro fertilization, there seems little question that alternate means were available to communicate this message.

In conclusion, the alternate means test is the most common sense element of all four elements of the test. Although all four factors could themselves become jury questions, the answer to the question

306. *Id.*

307. *Id.*

308. *Id.* at 142

309. *Id.* at 140

310. *Id.* at 141.

311. *Id.* at 142-43.

312. *Id.* at 143.

of whether the use was necessary to convey the message at hand is likely to be a relatively easily discernable one. Of course, as previously stated, a victory for the plaintiff on the fourth factor only puts the plaintiff on an even playing field with the defendant. It is only if the plaintiff makes it this far, that a court has to consider whether the right of publicity in a given action can trump the First Amendment.

V. Other Tests

While a variety of commentators have proposed methods for resolving the tension between the First Amendment and the right of publicity,³¹³ this section will analyze two prominent theories propounded recently by two state Supreme Courts. The first is a transformative balancing test, developed by the Supreme Court of California in 2001 in the *Comedy III Productions, Inc. v. Saderup, Inc.*³¹⁴ holding. In the second decision a predominant use test was established by the Supreme Court of Missouri in *Doe v. TCI Cablevision*.³¹⁵ While both tests have value, neither requires a court to examine enough elements to allow plaintiffs and defendants to be assured of a consistent holding time after time.

A. The *Comedy III* Test

Comedy III Productions, the registered owner of all rights to the former comedy act known as the Three Stooges brought a right of publicity action against Gary Saderup, an artist who created a charcoal portrait of the Three Stooges.³¹⁶ Saderup sold the portrait on both lithographs and T-shirts. The court acknowledged there was no implication that the "portraits"³¹⁷ were an advertisement or endorsement of a product or service, and therefore its holding could potentially have an explosive effect on the First Amendment and the right of publicity.³¹⁸

313. See, e.g., Ellis, *supra* note 230 (advocating a modified fair use analysis); Kwall, *supra* note 49 (advocating a property and liability analysis); Samuelson, *supra* note 28 (advocating an adoption of copyright's fair use defense).

314. 25 Cal. 4th 387, 387 (2001).

315. 110 S.W.3d 363, 374 (Mo. 2003).

316. *Comedy III Prods*, 25 Cal. 4th at 393. Although this action was brought under California's statute which allows for the descendability of publicity rights (CAL. CIV. CODE § 3344.1), the *Comedy III* test has been used both in and out of California in actions brought by the living.

317. *Comedy III Prods*, 25 Cal. 4th at 396.

318. If the court were to hold that Saderup's drawings and subsequent exploitation (Saderup had sold 1,415 lithographs and 2,265 T-shirts by the time of trial. Dougherty,

The court appeared cognizant of these ramifications, stating that the “right to self-expression is inherent in any political system which respects individual dignity. Each speaker must be free of government restraint regardless of the nature or manner of the views expressed unless there is a compelling reason to the contrary.”³¹⁹ Expanding on this thought process, the court stated:

It is admittedly not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity. Certainly any such test must incorporate the principle that the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity’s image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope.³²⁰

However, relying on *Zacchini*, the court forms a test based on the idea that the state’s interest in providing a right of publicity is not automatically trumped by the First Amendment, “rather as in the case of defamation, the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake.”³²¹ The court holds that “an action for infringement of the right of publicity can be maintained only if the proprietary interests at issue clearly outweigh the value of free expression.”³²²

Accordingly, the court’s new “balancing test between the First Amendment and the right of publicity [is] based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.”³²³ This transformative balancing test, is adopted from the first factor of

supra note 94, at 18-19), were protected speech, the potential effect would be that “an enormous source of celebrity wealth recognized for decades would be lost.” Dougherty, *supra* note 94, at 19. Professor Dougherty is referring to other celebrities, not simply the Three Stooges. *Id.*

319. *Comedy III Prods*, 25 Cal. 4th at 397. Furthermore, the court implies that the medium in which the work appears will not be seen as dispositive stating, “[n]or does the fact that Saderup’s art appears in large part on a less conventional avenue of communications, T-shirts, result in reduced First Amendment protection.” *Id.* at 399.

320. *Id.* at 403. The court added that the “right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment.” *Id.* at 397.

321. *Id.* at 401.

322. *Id.* at 402, quoting *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d at 860, 871 (1979).

323. *Comedy III Prods*, 25 Cal. 4th at 391.

the copyright fair use doctrine:³²⁴ the “purpose and character of the work.”³²⁵ The first factor is grounded in a determination of whether the work in question is transformative.³²⁶ The court reasons that the underlying justification for the test is that “when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.”³²⁷

The test is essentially “whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather the celebrity’s likeness . . .”³²⁸ and this “inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”³²⁹ However, the court provides no guidance in how other courts should make such determinations and by not doing so only encourages jurists to be art critics. As noted above, this is the last role our society has envisioned for those trained solely in the law.³³⁰ In the alternative, such a question of transformativeness could easily lead to a new brand of expert testimony: the is-it-imitative-or-is-it-creative expert. Soon these experts could flood the courts testifying as to the literalness of a depiction.

Although the *Comedy III* court stated that the “test we articulate today . . . does not express a value judgment or preference for one type of depiction over another,”³³¹ it is hard to believe the court. By elucidating a test that emphasizes that which is not literally depictive of celebrity over that which is, the court has not simply stopped the *Saderup*’s of the world. The unintended consequences of the

324. *Id.* at 404.

325. 17 U.S.C. § 107(1) (2003).

326. *Id.*, citing *Campell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). “This inquiry into whether a work is ‘transformative’ appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment.” *Comedy III Prods*, 25 Cal. 4th at 404.

327. *Id.* at 405. The court unfortunately provides no evidence for its conclusion that a transformative work will be less likely to effect the economic interest intended to be protected by the right of publicity. In fact, one could argue that such a theory is in direct contrast to the theory of the tragedy of the commons. See Hardin, *supra* note 55. But see Dougherty, *supra* note 94, at 25 (arguing that works that are not a true representation of the celebrity “are not likely to be good substitutes for authorized celebrity memorabilia”).

328. *Comedy III Prods*, 25 Cal. 4th at 406 (defining expression as “something other than the likeness of the celebrity”).

329. *Id.* at 407.

330. See note 110 and accompanying text.

331. *Id.* at 409.

transformative test could surpass the court's intent very quickly. To name only one example, may performers no longer imitate celebrities because their depictions are too close to the real thing? Perhaps only the good imitators will be enjoined though, because the celebrity impersonators that are not convincing, will no longer be seen as poor imitations of the original, they will now be labeled "creative." It certainly appears that the *Comedy III* court's transformative test made a value determination that the statutory right of publicity can, and at times should, trump the First Amendment.

B. The Predominant Use Test

In *Doe v. TCI Cablevision*,³³² the plaintiff, former professional hockey player Anthony "Tony" Twist³³³ brought a misappropriation action³³⁴ against the creator of the comic book *Spawn*.³³⁵ The plaintiff's complaint was based on a character named "Anthony 'Tony Twist' Twistelli" that the defendant openly admitted was based on the plaintiff.³³⁶ Twist won a jury verdict for \$24,500,000, but the court granted a motion for judgment notwithstanding the verdict.³³⁷

In a right of publicity action in Missouri the:

[P]laintiff must prove that defendant intended to obtain a commercial advantage, and it is not enough to show that defendant incidentally obtained a commercial advantage by using plaintiff's name or that defendant had some other purpose in using plaintiff's name other than to obtain a commercial advantage.³³⁸

332. 110 S.W.3d 363 (Mo. 2003).

333. Twist was mainly known for his "violent tactics" as a player in the National Hockey League. *Id.* at 366.

334. The actions sounded in "misappropriation of name and defamation." *Id.* at 365. However, the defendant invoked a First Amendment defense and the court acknowledged that although the damages are different, the "elements of the two torts [misappropriation and the right of publicity] are essentially the same." *Id.* at 368.

335. Described as a "dark and surreal fantasy centered on a character named Al Simmons, a CIA assassin who was killed . . . and descended to hell . . . Simmons, having made a deal with the devil, was transformed into the creature Spawn and returned to earth to commit various violent and sexual acts on the devil's behalf." *Id.* at 366. The action was brought against various companies associated with the comic book series. *Id.* at 367.

336. *Id.* at 366. The "fictional 'Tony Twist' is a Mafia don whose list of evil deeds includes multiple murders, abduction of children and sex with prostitutes." *Id.* The creator of the series was an "avowed hockey fan" and on more than one occasion spoke about how the Tony Twist character was based on the plaintiff. *Id.* at 366.

337. *Id.* at 365.

338. *Id.* at 369.

However it is “irrelevant whether defendant intended to injure the plaintiff or actually succeeded in obtaining a commercial advantage from using plaintiff’s name.”³³⁹

Not surprisingly, the court uses “commercial advantage” as the foundation of its test, explaining that the “threshold legal question [is] whether the use . . . is ‘expressive,’ in which case it is fully protected, or ‘commercial’ in which case it is generally not protected.”³⁴⁰ Examples such as news or entertainment are usually expressive and fall under the protection of the test, while purely commercial uses, like those for goods or services will “rarely” be protected.³⁴¹ The Missouri Supreme Court then distinguishes its test from the *Comedy III* test by pointing to the possibility that an expressive work, regardless of whether it is commercially exploiting the plaintiff will be a protected work if transformative under *Comedy III*.

However, the *Doe* court’s predominant use test is designed to address works that are both expressive and commercial by holding that even a use with expressive elements will be held violative of the First Amendment if its primary purpose is one of commerciality.³⁴² At the same time, a work that is mainly designed to “make an expressive comment on or about a celebrity,” will likely be protected, as the predominant purpose of the use is to make the expressive comment.³⁴³

Although the Missouri court’s predominant use test is much younger than the *Comedy III* transformative test, that has not prevented at least one commentator from already questioning its effectiveness. He asks what about the:

[u]se of a private person’s persona, such as the girls caught flashing in the “Girls Gone Wild” videos? And what if the “expressive comment” is the image itself, such as a picture book of celebrities? How is the finder of fact supposed to distinguish a “predominant purpose” of making an expressive comment from that of making a buck, when the two go hand in hand?³⁴⁴

Perhaps even more problematic is the determination of exactly what is expressive and what is commercial. As discussed in Part IV, A and B above, neither are easily made distinctions and one would suspect continued erratic holdings based on a test that calls for a court not only to determine if a work is expressive, but if it is

339. *TCI Cablevision*, 110 S.W.3d at 371, citing MCCARTHY, *supra* note 7, at § 3.28.

340. *TCI Cablevision*, 110 S.W.3d at 373.

341. *Id.*

342. *Id.* at 374.

343. *Id.*, quoting Lee, *supra* note 90, at 500.

344. Moore, *supra* note 12, at 6.

predominantly commercial. Beyond the obvious fact patterns, this test does not appear to be a vast improvement on the *Comedy III* test.

VI. Testing the Four Factors

This penultimate section will apply the above four factor test to four relatively recent and influential right of publicity cases involving the First Amendment. It should be remembered that if the plaintiff fails to show any of the elements of the test, it will lose, while even if all four elements are proven by the plaintiff, a victory is not guaranteed. The four factors are: Does the use *evoke* the image or persona of the plaintiff? Is the use *related* to the plaintiff's public persona? Is the use an *advertisement in disguise*? Are *alternate means* of conveying the defendant's message available?

A. Testing The Stooges³⁴⁵

As discussed in Part IV, a determination of the newsworthiness/public interest of Gary Saderup's charcoal sketch, just as with all other similar works is less a science than an art. The California Supreme Court determined that the work was commercial art, and therefore not deserving of the "high degree of First Amendment protection for noncommercial speech about celebrities"³⁴⁶ Nevertheless, the court decided that the work is art, and recognized that even commercial art is deserving of some protection, after all, as one commentator has noted "like entertainment, art is protected speech."³⁴⁷

Yet, the court wanting to avoid the role of art critic, created the following standard to help make its decision as to the protectability of Saderup's work: "does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity

345. *Comedy III* will be treated as if the plaintiffs were alive, thereby avoiding the some of the descendability issues that might otherwise arise.

346. *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387, 399 (2001). It was the determination that Saderup's work was not expressive speech, but not an advertisement either that led the court to develop its 'transformative test.'

347. Dougherty, *supra* note 94, at 16, *citing* *Hurley v. Irish-Am. Gay, Lesbian, & Bisexual Group of Boston*, 515 U.S. 557 (1995). Though one may quibble with Saderup's rendering of the Three Stooges being classified as "art," the California Supreme Court in *Comedy III* contrasts Saderup's drawing of the Three Stooges with that of Andy Warhols' renderings of "such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley." 25 Cal. 4th at 408-09.

depicted?”³⁴⁸ Of course if the answer is “no,” then the artist would be in the clear. Additionally, the court explains, if the “value of the work” is derived from a “source” different than the actual celebrity, be it the artist’s “creativity, skill and [or] reputation . . . it may be presumed that sufficient transformative elements are present to warrant First Amendment protection.”³⁴⁹

The Court refers to the late Andy Warhol as an example of an artist who produced “celebrity portraits” that were protected by the First Amendment because through “distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.”³⁵⁰ The court’s use of Warhol and a test that examines the reputation of the artist, has been derided by one commentator because: “aside from extreme cases, it is difficult to measure an artists’ fame and weigh it against that of the subject. Under this test, presumably Andy Warhol could sell copies of literal depictions of anyone, except perhaps someone more famous than he is. One wonders who that would include.”³⁵¹

Saderup argued that “all portraiture involves creative decisions,” and “that therefore, no portrait portrays a mere literal likeness, and that accordingly all portraiture, including reproductions, is protected by the First Amendment.”³⁵² However, the court was not listening:

We reject any such categorical position. *Without denying* that all portraiture involves the making of artistic choices, we find it equally undeniable, under [the transformative] test, that when an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist’s right of free expression is outweighed by the right of publicity.³⁵³

The court uses all of two paragraphs to determine that despite Saderup’s “undeniable skill,” such skill was “subordinated to the overall goal of creating literal, conventional depictions of the Three

348. *Id.* at 407. The United States District Court for the Southern District of New York has boiled down this part of the *Comedy III* reasoning to: “whether it is the art or the celebrity that is being sold or displayed.” 200 F. Supp. 2d 340, 349 (S.D.N.Y. 2002).

349. 25 Cal. 4th at 407. The reputation test seems a bit unreliable. After all, if a famous artist made the same sketch as Saderup, and put it on T-shirts, but if the public knew the artist, does that mean the work is transformative?

350. *Id.* at 408-09.

351. Dougherty, *supra* note 94, at 48.

352. 25 Cal. 4th at 408.

353. *Id.* (emphasis added).

Stooges so as to exploit their fame.”³⁵⁴ Accordingly, because the “marketability and economic value” of the work “derived primarily from the fame of the celebrities depicted,”³⁵⁵ the work is not transformative, and because Saderup’s work did not possess the necessary significant creative elements to be transformative, the lower courts’ ruling in favor of *Comedy III* was affirmed.³⁵⁶ Without pause the court justifies this ruling on the basis of its theory that if it held the drawing transformative and protected by the First Amendment “we cannot perceive how the right of publicity would remain a viable right other than in cases of falsified celebrity endorsements.”³⁵⁷

However, as one commentator has noted, under the *Comedy III* test, if a court were to determine that a “particular work of art is transformative, then presumably it can be attached to any unrelated product and sold.”³⁵⁸ Therefore, “[r]ather than regulating the sale of image merchandise otherwise associated with the person depicted, the transformativeness rule prevents the dissemination of copies of pictorial works assessed by a judge to be insufficiently creative and is likely to chill the creation of pictorial works portraying real people.”³⁵⁹ Another commentator uses a hypothetical “sequel to ‘The Fugitive’ starring a digital version of Harrison Ford [which] would be protected as a ‘transformative’ work,” to demonstrate the “patently absurd result” of the test.³⁶⁰ Few would argue that an Andy Warhol “Marilyn Monroe” ashtray being approved while a Gary Saderup “Three Stooges” T-shirt is held impermissible seems to be in opposition to common sense.³⁶¹

Yet, for present purposes it shall be assumed that a court did not find the work in question to be expressive per se as it is not fictional like *Rogers* or factual like *Dora*. However, if a nude picture of Ann-Margret or a commercial for a commercial award show are held to be of interest to the public, surely a finely wrought, accurate artistic

354. *Id.* at 409. Ironically, there is little doubt that it actually took a great deal of Mr. Saderup’s “undeniable skill” to create such “literal, conventional depictions.”

355. *Id.*

356. *Id.*

357. *Id.*

358. Dougherty, *supra* note 94, at 70.

359. *Id.*

360. Moore, *supra* note 12, at 6. Moore contends the *Comedy III* transformative balancing test is “rather rudderless.” *Id.*

361. In *Comedy III* the court actually writes: “[n]or does the fact that Saderup’s art appears in large part on a less conventional avenue of communications, T-shirts, result in reduced First Amendment protection.” 25 Cal. 4th at 399. See Section VI.A for further discussion.

rendering of the Three Stooges could hold a similar interest.³⁶² And, if there were such public interest, how would the plaintiff in *Comedy III* have fared under the four factor test?

It can be easily shown that *Comedy III* would pass the first element, as a portrait of the Three Stooges is certainly evocative of the comedy troupe. As to the element of the purpose of the use of the persona, as the *Factors, Etc., Inc. v. Creative Card Co.*³⁶³ court might have said, there is no constitutional right to the use of the Three Stooges as the Three Stooges. Hence, the plaintiff would succeed on the second element. However, it is on the third step of the test that *Comedy III Productions* would clearly fail. The use of a portrait of the Three Stooges, be it in T-shirt or lithograph form is not an advertisement in disguise any more than a print of a Monet painting is an advertisement in disguise.³⁶⁴ Unless one were to attempt to argue that the portrait of Larry, Moe and Curley was an advertisement for blank white T-shirts, it is difficult to separate this version of art from a Warhol celebrity rendering. Accordingly, the defendant would be successful under the four factor/First Amendment analysis.³⁶⁵

B. LaFacing the Music

The second recent decision was delivered in 2003 by a panel in the Sixth Circuit.³⁶⁶ The plaintiff, famed civil rights activist Rosa Parks,³⁶⁷ brought an action for violation of her common law right of

362. Perhaps the work that has been reviewed above that hues closest to *Comedy III* is the artist's rendering of Joe Montana in *Montana*. However, that the picture was created for a newspaper, such a traditionally protected medium of expression makes direct comparisons difficult.

363. 444 F. Supp. 279 (S.D.N.Y. 1977). See note 249 and accompanying text.

364. It should be noted that such logic should not be extended indefinitely. If *Saderup* instead of simply creating a portrait and putting it on T-shirts and lithographs, made Three Stooges Pez dispensers, clearly the use would be an advertisement in disguise for selling Pez. See *Lugosi v. Universal Pictures*, 25 Cal. 2d 813, 851 (1979) (Bird, C.J. dissenting) ("the sale of such objects as plastic toy pencil sharpeners, soap products, target games, candy dispensers and beverage stirring rods [emblazoned with Lugosi-as-Dracula] . . . hardly implicates the First Amendment."). But see *Hoepker v. Kruger*, 200 F. Supp. 2d 342 (S.D.N.Y. 2002) (holding that speech can be disseminated both for free and for profit, and that "[m]useum gift shops sell merchandise that, in general, replicates the art displayed in the museum, thus enabling the museum to distribute art in a common and ordinary form that can be appreciated in everyday life."). *Id.* at 354.

365. For the sake of completeness, the defendant would win the fourth test as well, since there is no sufficiently accurate alternate means of picturing the Three Stooges beyond the use of a likeness of the Three Stooges.

366. *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

367. Parks achieved national recognition in 1955 by refusing to yield her seat on a bus to a white passenger in Montgomery, Alabama, as segregation laws of the time required.

publicity under Michigan law,³⁶⁸ against the record producers of the recording artists OutKast, for their song "Rosa Parks."³⁶⁹ The chorus of the song was "Ah, ha, hush that fuss[.] Everybody move to the back of the bus."³⁷⁰ The trial court granted the defendants' motion for summary judgment on the publicity claim, despite determining that the chorus of the song was clearly related to the plaintiff's name and fame, and such a relationship was "so obvious that the matter is not open to reasonable debate."³⁷¹

The Sixth Circuit overturned the district court decision on the right of publicity and trademark claims.³⁷² The court defined the plaintiff's burden in such a case to be a demonstration "that she has a pecuniary interest in her identity, and that her identity has been commercially exploited by [the] defendant."³⁷³ The court explained that such a burden had been met because:

We believe that reasonable people could find that the use of Rosa Parks' name as the title to this song was not justified as being metaphorical or symbolic of anything for which Rosa Parks is famous. To the contrary, reasonable people could find that the *name was appropriated* solely because of the vastly increased marketing power of a product bearing the name of a national heroine of the civil rights movement.³⁷⁴

The court then attempted to "apply a legal standard of 'artistic relevance'" in order to balance the rights of the parties and in so doing, held that an "[a]pplication of that standard involves a recognition that Rosa Parks has no right to control her image by censoring disagreeable portrayals."³⁷⁵ Yet, in a lucid assessment of the rights of artists in a publicity action, the court wrote there must be a "recognition that the First Amendment cannot permit anyone who

A boycott of the city buses which lasted more than one year followed Park's action and "eventually became a catalyst for organized boycotts, sit-ins, and demonstrations all across the South." *Id.* at 442.

368. Parks also alleged false advertising under the Lanham Act, defamation and tortious interference with a business relationship. *Id.* at 441.

369. *Id.* at 442.

370. *Id.*

371. *Id.* at 452.

372. *Parks*, 329 F.3d at 463.

373. *Id.* at 460. Both parties stipulated as to the plaintiff's fame and the defendant's did not dispute they had named their song after Parks, but claimed a "First Amendment right of artistic expression." *Id.*

374. *Id.* at 454 (emphasis added). This was opposed to the district court's opinion that the line in the chorus was a "statement by OutKast to competing rappers that their work is of 'lesser quality' than OutKast's and therefore other rappers should 'take a backseat' to OutKast." ENT. L. REP., Vol. 25, No. 5, 11 (2003).

375. *Parks*, 329 F.3d at 463.

cries 'artist' to have *carte blanche* when it comes to naming and advertising his works."³⁷⁶ The Sixth Circuit held that whether OutKast "filch[ed]" Rosa Parks' name should be left to a trier of fact and reversed and remanded for retrial.³⁷⁷

Is the use of Rosa Parks' name in a hip hop song newsworthy or in the public interest? Although a gut reaction might say, "neither," there is little question that a court would hold that the use of the name itself is a protected form of expression. In its holding for the defendant in *Rogers v. Grimaldi*³⁷⁸ the district court quoted the United States Supreme Court, "[e]ntertainment, as well as political and ideological speech, is protected; motion pictures, programs broadcast by radio and television and live entertainment, such as musical and dramatic works fall within the First Amendment guarantee."³⁷⁹ The Second Circuit in its affirmation of *Rogers* held that "[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection."³⁸⁰ However, the court continued, if the plaintiff could demonstrate there was "no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, [if] the title explicitly misleads as to the source or the content of the work," only then could protection under the First Amendment be removed.³⁸¹

However, a song that uses the phrase "Ah ha, hush that fuss[.] Everybody move to the back of the bus,"³⁸² would seem to contain at least a modicum of artistic relevance to the publicly known persona of Rosa Parks. Accordingly, there is no dispute that the use of Ms. Parks name evokes her public persona, hence meeting the first factor of the four factor test. While one might argue as to whether the use here is actually *related* to the plaintiff's public persona,³⁸³ if the use is deemed artistically relevant and therefore protected, it is only because the song is at least tangentially related to the public image of Rosa Parks. Though it might be a close call, the second element is satisfied.

376. *Id.*

377. *Id.*

378. 695 F. Supp. 112 (S.D.N.Y. 1988).

379. *Id.* at 116, *quoting* *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 68 (1981).

380. *Rogers v. Grimaldi*, 875 F.2d 994, 997 (1989).

381. *Id.* at 999.

382. *Parks*, 329 F.3d at 442.

383. See note 371 and accompanying text (discussing the true motivations for using Ms. Parks' name).

The third factor would be a difficult one to address as well. Despite the usual status of songs as protected speech,³⁸⁴ a strong case could be made that the only reason Parks' name was being used was to attract commercial attention to the Outkast record. If this could be proven at trial, Parks might have an outside chance of winning this part of the test. Admittedly such an argument would be an uphill climb, and if the plaintiff failed to convince the court the defendant would win the four factor test automatically.

For the sake of argument though, if the plaintiff were to prevail on the third count, which is unlikely, it would have an excellent chance of prevailing on the fourth element of the test. There must be alternative ways to communicate the message that Outkast was intending to send to its listeners, without the appropriation of Ms. Parks' persona. Overall, under the four part test, unless Parks was able to convince a court that the sole motivation for the use of her name as the title of the song was as an advertisement in disguise, the defendant would be victorious.

C. Testing "Tiger"

The third action is the Sixth Circuit's holding against Eldrick "Tiger" Woods under the Ohio common law right of publicity. In *ETW Corp. v. Jireh Publishing, Inc.*,³⁸⁵ Woods, chairman of the board of ETW, brought a right of publicity³⁸⁶ action against the publisher of Rick Rush's artwork. Rush's work was a painted image of Woods, commemorating his winning of the Master's golf tournament in Augusta, Georgia, in 1997.³⁸⁷ Woods has assigned the "exclusive right

384. See *supra* note 378 and accompanying text (arguing songs are invariably protected).

385. 332 F.3d 915 (6th Cir. 2003).

386. *Id.* at 919. ETW also alleged a variety of trademark violations under the Lanham Act and unfair competition and deceptive trade practices under Ohio law. ETW's trademark claim failed as the Sixth Circuit held: "ETW asks us, in effect, to constitute Woods himself as a walking, talking trademark. Images and likenesses of Woods are not protectable as a trademark because they do not perform the trademark function of designation... as a general rule, a person's image or likeness cannot function as a trademark." *Id.* at 922.

387. *Id.* at 918. Woods was the youngest competitor to ever win the tournament and did so by a record-setting margin. *Id.* The image presents three different views of Woods, his caddy and a competitor's caddy all in the foreground. In the background is a row of past winners of the tournament, and behind them is the scoreboard for the tournament. The past winners include Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones and Jack Nicklaus. Jireh created a series of "limited edition prints"—two hundred and fifty large serigraphs and five thousand smaller lithographs of the work, which was entitled "The Masters of Augusta." *Id.* at 919.

to exploit his name, image, likeness and signature, and all other publicity rights” to ETW.³⁸⁸

The district court granted summary judgment to the defendant on all counts, based mainly on the strength of its First Amendment affirmative defense, and the Sixth Circuit affirmed on all counts. The panel quoted the *Comedy III* holding: “Saderup’s portraits were entitled to First Amendment protection because they were ‘expressive works and not an advertisement or endorsement of a product.’”³⁸⁹ Referring to Rush’s painting confusing anyone as to its source, the court predicted: “[n]o reasonable person could believe that merely because these photographs or paintings contain Woods’ likeness or image, they all originated with Woods.”³⁹⁰ The majority strongly believed that Rush’s image had “substantial informational and creative content,”³⁹¹ and hence found the work transformative. After “balancing the societal and personal interests embodied in the First Amendment against Woods’ property rights, we conclude that the effect of limiting Woods’ right of publicity in this case is negligible and significantly outweighed by society’s interest in freedom of artistic expression.”³⁹²

388. *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d at 918. Additionally, ETW holds a trademark in the mark “Tiger Woods,” for “use in connection with ‘art prints, calendars, mounted photographs, notebooks, pencils, pens, posters, trading cards, and unmounted photographs.’” *Id.*

389. *Id.* at 935, quoting *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387, 396 (2001). The court noted that Saderup lost due to his paintings being found to fail the transformative test. *Id.*

390. *Id.* at 923.

391. *Id.* at 937. It is these types of holdings that led one commentator to ask “should constitutional protection turn on a judge’s view as to whether a work of art is simple-minded and imitative, or instead conveys ‘ironic social comment?’” Lewis R. Clayton, *THE NATIONAL L.J.*, July 16, 2001, A23. Perhaps ironically, in its *Amici* brief on behalf of Jireh, The Reporters Committee for Freedom of The Press argued against judges being put “in the position of deciding whether a use was sufficiently creative or newsworthy to be permitted.” *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 615.

392. *Id.* at 938. A celebrity like Woods only serves to highlight the greatest paradox of the right of publicity: a celebrity that is worth more in endorsement money than he is for the activity that made him famous to begin with is seen as being less entitled to a strong protection of any future exploitation because he has been so successful at exploiting his persona already. In this particular action it was to Woods’ detriment that he had become “an important element of the shared communicative resources of our cultural domain.” *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d at 933, quoting *Cardtoons*, 95 F.3d at 972. Woods falls into that small category which has seen “[a]n entire industry . . . develop [a]round the merchandising and commercial exploitation of endorsements which often surpass the monies earned directly through performance by entertainers and sports stars.” Leonard M. Marks & Robert P. Mulvey, *Celebrity Rights Law Needed in New York*, N.Y. L.J., at 1 (1995).

In respect to the four-factor test, while the sides in *Jireh* clashed over the transformative nature of the work, neither side quibbled about the protected nature of a portrait in terms of its public interest. In fact, a strong case could be made for the painting attaining the status of newsworthy as it pictured the star of a major sporting event.³⁹³ In either case, *Jireh* should easily make it to the four factor test. Clearly, the painting of Woods evokes his image, and he is shown golfing, the activity that made him famous, so both the first and second elements have been fulfilled. Although the dissent would disagree,³⁹⁴ by using the same rationale as used above for *Comedy III*, one should ask: if Rush is using Woods image as an advertisement in disguise, what is he advertising? What Rush is selling is his rendering of Woods. The same as Warhol or Saderup before him. Which of the three is the most or least artistic should be left to the art critics, not the courts; the plaintiff fails on the third factor.³⁹⁵ The Sixth Circuit was correct in holding for *Jireh* and the First Amendment.

D. A Test for Tony Twist

As described above, *Doe v. TCI Cablevision*³⁹⁶ involves the use of the plaintiff Tony Twist's name and some of his characteristics as the basis for an unflattering comic book character. The Missouri Supreme Court, invoking its newly created predominant purpose of the use test, held that as the use of the plaintiff's name was not a parody:

393. In other words, were Rush a photographer, no one would question his right to take a picture of Woods and sell it to a magazine. See *Gautier v. Pro-Football, Inc.*, 304 N.Y. 354 (1952) (holding that the use of a name or picture in a newspaper, magazine, or newsreel, in connection with an item of news of one that is newsworthy, is not a use for purposes of trade, and therefore is not a violation of New York's right to privacy statute). But see *Mendonsa v. Time, Inc.*, 678 F. Supp. 967 (D.R.I. 1988) (holding that the subject of the famous "Kissing Sailor" photo taken on VJ Day in Times Square had his likeness misappropriated by defendant's selling prints of the picture for \$1,600 each).

394. "It is difficult to discern any appreciable transformative or creative contribution in Defendant's prints so as to entitle them to First Amendment protection." 332 F.3d at 959 (Clay, J., dissenting). The dissent continued:

[A]lthough it is apparent that Rush is an adequately skilled artist, after viewing the prints in question it is also apparent that Rush's ability in this regard is subordinated to the overall goal of creating literal, conventional depictions of Tiger Woods so as to exploit his . . . fame such that Rush's right of free expression is outweighed by Wood's right of publicity.

Id.

395. Also similarly to *Comedy III*, the plaintiff would fail on the fourth element as well; after all, it would be hard to tell the story of Tiger Woods winning the Masters without Tiger Woods.

396. 110 S.W.3d 363 (Mo. 2003) *reh'g denied* by *McFarlane v. Twist*, 2004 U.S. LEXIS 76 (US 2004). See Section VI.B for factual background.

or other expressive comment or a fictionalized account of the real Twist [Such use] has very little literary value compared to its commercial value. [Therefore] the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.³⁹⁷

The court essentially held there was nothing newsworthy or in the public interest about this use of the plaintiff's name, a startling finding of a use involving a comic book, a use that is so traditionally protected.³⁹⁸ Yet, because the "respondents agree . . . that the use was not a parody . . ."³⁹⁹ it makes it difficult to disagree with the court's holding. After all, there is no question that the story is not true to life, and if it is not parody or a "fictionalized account of the real Twist,"⁴⁰⁰ the arguments for expressiveness seem to evaporate. *Doe* would most likely not be held newsworthy or in the public interest and accordingly would fail to even reach the four factors test.

However, if *Doe* made it to the four factors, the defendant would likely prevail. While Twist is certainly evoked by the use of his name, the use of his likeness as a "Mafia don whose list of evil deeds includes multiple murders, abduction of children and sex with prostitutes,"⁴⁰¹ would seem to range far afield from playing hockey. Although it appears the defendant is being rewarded for so altering the persona of the plaintiff, this is intentional. After all, if the use were deleterious to the plaintiff, he could surely bring a defamation action. As far as the right of publicity is concerned, it should be victorious in *Doe*, as the defendant is unable to even put the "puck in play."

VII. Conclusion

As the right of publicity enters into its second fifty years, it has begun to bash heads with that most obstinate of foes, the First Amendment. While some argue that the right has intruded too far onto the sacred ground of the right of free speech, others would argue the opposite: that the First Amendment has rendered the right of publicity useless. The right of publicity is hampered less by doctrinal

397. *Id.* at 374.

398. One suspects that defendants' repeated admissions in both interviews prior to trial and at trial that the character was based on the plaintiff was a very influential factor in the decision by the court. See note 334 and accompanying text.

399. 110 S.W.3d at 374.

400. *Id.*

401. *Id.* at 366.

conundrums than a continuing struggle for its true *raison d'être*. The *Jireh* decision provides a classic example of a court struggling with the issue of not “how” to enforce the right of publicity, but “for whom” should it be enforced?

The court explains its holding against Woods by reasoning “in the absence of his right of publicity, [Woods] would still be able to reap substantial financial rewards from authorized appearances and endorsements.”⁴⁰² It is hard to believe that the court would necessarily have held the same way if the plaintiff had not been a multi-millionaire. Or at the very least, it would have adhered closer to the First Amendment justification in its decision. In support of the majority’s reasoning, a group of law professors has argued that they “doubt that Tiger Woods would have lacked the motivation to excel as a professional golfer if he knew that, should he become famous, he could not license out his image for posters and other memorabilia.”⁴⁰³ This argument does not hold much legal water.

Either the right of publicity in the United States is worthy of protection, or it is not. To continue to put our courts in the position of determining *if* a given celebrity *would* have been motivated *if* they *knew* what *might* happen to their right of publicity in the *future* appears to be an awfully crude means of producing consistent decisions.

As one practitioner writes, the overwhelming fear of chilling free speech has led to a broad leeway given to free expression, so much so that “merely to be sued is to lose, even if the defendant ultimately wins the case.”⁴⁰⁴ Despite some recent decisions for defendants, the best course of action for possible future defendants is to negotiate for and obtain licensing agreements from the celebrity in question or to not use the celebrity persona at all. At the same time, Professor Madow argues that until a “clear and convincing showing is made that

402. *ETW v. Jireh Publishing, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003). How does the court know what the future holds for the plaintiff? While at the time of a given action a celebrity might be fabulously famous and wealthy, “fame and reputation are not static, but rather can change during and after a person’s life.” Dougherty, *supra* note 94, at 48. Aside from the possible “tragedy of the commons” (see Hardin, *supra* note 55 and accompanying discussion), is society now dictating that one cannot exploit their own ‘property’ to the fullest extent that they wish? And if society has made such a determination, should such a determination be made by an unelected judiciary?

403. Brief of Amici Curiae of 73 Law Professors in Support of Defendant/Appellee *Jireh Publishing, Inc.*, at 28, *ETW v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003) (No. 00-3584). The professors add that many other countries, (England amongst them) do not recognize the right of publicity in any way.

404. Moore, *supra* note 12, at 6.

very substantial social interests will thereby be served”⁴⁰⁵ no right of publicity should be recognized.

It is due to these conflicts that the four factor test was developed. The test should help courts make consistent, logical rulings in right of publicity actions that implicate the First Amendment. Until our legislatures at either the federal or state level have come to more consistent terms with how the right of publicity is to be treated by our jurists, a steadying hand is needed to create reliable decisions time after time. By borrowing from the existing doctrines of intellectual property and crafting a test that is geared towards protecting free speech but not at the cost of eliminating the right of publicity, the four factor test should provide all parties with stability, until the right of publicity reaches at least its one hundredth anniversary.

405. Madow, *supra* note 49, at 239.